Supreme Court, U.S.
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No. 01-

IN THE
Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
AND MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

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QUESTIONS PRESENTED

1. Whether a publisher's exact, image-based reproduction of a collective work in CD-ROM format infringes the copyrights of freelance contributors to that collective work.

2. Whether an applicant for a copyright registration perpetrates a "fraud" on the Copyright Office when the applicant discloses "the material . . . in which copyright is claimed," as the Copyright Office requires, and the Copyright Office itself insists that the applicant provided full disclosure.

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

Petitioners National Geographic Society, National Geographic Enterprises, Inc., and Mindscape, Inc., were defendants/appellees below. Petitioner National Geographic Society is a not-for-profit membership organization. Petitioner National Geographic Enterprises, Inc. (now named National Geographic Holdings, Inc.) is a wholly owned subsidiary of NGV, Inc., which in turn is a wholly owned taxable subsidiary of petitioner National Geographic Society. Petitioner Mindscape, Inc. (now incorporated under the name Mindscape LLC) is wholly owned by Mindscape Holdings LLC, and no publicly held company owns 10% or more of its stock.

Respondents Jerry and Idaz Greenberg were plaintiffs/appellants below.

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INTRODUCTION

This case is about the preservation of collective works (including magazines, newspapers, and encyclopedias) for the education and entertainment of future generations. The Copyright Act grants freelance authors the copyrights in their individual contributions to collective works, but grants the publishers of such works a privilege to reproduce such contributions "as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series." 17 U.S.C. § 201(c). As this Court recently recognized, that provision strikes a fundamental balance between the rights of authors and publishers: a publisher may not exploit an individual freelance contribution outside the context of the collective work, but may reproduce the collective work itself in a new medium. *New York Times Co. v. Tasini*, 121 S. Ct. 2381, 2391-92 (2001).

In this case (decided before *Tasini*), however, the Eleventh Circuit effectively wrote this privilege out of the United States Code. At issue here is "The Complete National Geographic" (CNG), a thirty-disc CD-ROM set reproducing each monthly issue of *National Geographic* magazine from 1888 through 1996. Every page of every issue remains as it was in the original print version, including *all* page arrangements, stories, photographs, graphics, advertising, and attributions. A user thus encounters all freelance contributions (in the words of the *Tasini* Court) in "the context provided . . . by the original periodical editions." 121 S. Ct. at 2390-91. The conversion to CD-ROM format "represent[s] a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another." *Id.* at 2392.

The Eleventh Circuit nonetheless held that Section 201(c) did not apply because the CNG is a "new collective work," and, in the court's view, the creation of a new collective work necessarily defeats the statutory reproduction privilege. App. 9a-13a. That is simply incorrect. Section 201(c) allows a publisher to reproduce a freelance contribution in the "particular collective work" to which the author contributed, or "any revision of that collective work," regardless of whether

the publisher thereby creates a "new" and larger collective work. That is precisely why, as the *Tasini* Court emphasized, Section 201(c) authorizes the reproduction of a paperbound collective work in the different media of microfilm or microfiche, even though "the microfilm roll contains multiple editions." 121 S. Ct. at 2391. As long as each individual contribution remains in its "original context," the publisher has not infringed the author's copyright. *Id.*

It is hard to overstate the practical consequences of the decision below. Rather than preserving a balance between the author's copyright in an individual contribution and a publisher's copyright in the collective work as a whole, the decision gives freelancers the power to stop publishers from creating electronic archives of their collective works. As a practical matter, no publisher could create such an archive if exact, image-based reproductions of past issues were to violate freelancers' copyrights. Thus, if allowed to stand, the decision below would prevent publishers, including National Geographic, from creating and preserving electronic archives for the benefit of history and unknown generations of individuals, students, and scholars. That result turns Section 201(c)—and *Tasini*—upside down.

And the Eleventh Circuit was not content merely to strip National Geographic of its statutory reproduction privilege. In addition, the court accused the Society of having "perpetrated a fraud on the Copyright Office," by having "failed to indicate" the existence of the CD-ROM's computer program when registering the CNG. That accusation is manifestly incorrect, because the Copyright Office requires an applicant in a multimedia work like the CNG to set forth "all the new copyrightable authorship *that is the basis of the present registration*," and the Society never claimed authorship of the computer program. That may explain why this issue was never briefed or argued until the Eleventh Circuit *sua sponte* launched the accusation in its opinion. What remains unexplained (and inexplicable), however, is the Eleventh

Circuit's refusal to correct this error, even after it was brought to the court's attention on rehearing, and even after *the Copyright Office itself* explained that the court had misconstrued its disclosure requirements. This Court should not allow the lower courts thus to besmirch a litigant's reputation, and to disregard a federal agency's interpretation of its own rules of practice and procedure.

OPINIONS BELOW

The Eleventh Circuit's "corrected" opinion is reported at 244 F.3d 1267 and reprinted in the Appendix ("App.") at 1a-21a. That opinion reflects a number of changes made by the Eleventh Circuit while the petition for rehearing was pending. For this Court's convenience, the passages of the original opinion omitted from the "corrected" opinion are indicated with strikeout text, App. 16a, and the passage added to the "corrected" opinion is indicated with highlighted text, *see id.* The unreported order denying the petition for rehearing and rehearing *en banc* is reprinted at App. 22a-23a. The district court's unpublished order and opinion granting petitioners' motion for summary judgment is reprinted at App. 37a-44a.

JURISDICTION

The Eleventh Circuit entered judgment on March 22, 2001. Petitioners timely filed a petition for rehearing and rehearing *en banc*, which was denied on June 8, 2001. App. 22a-23a. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

PERTINENT STATUTORY PROVISION

Section 201(c) of the Copyright Act provides:

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege

> of reproducing and distributing the contribution as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series.

17 U.S.C. § 201(c).

STATEMENT OF THE CASE

Petitioner National Geographic Society is the world's largest nonprofit scientific and educational organization, with approximately ten million members worldwide. The Society engages in promoting and funding scientific research, exploration, and grants for geography education, and has given more than 7,000 grants for scientific research. Since its founding in 1888, the Society has published a monthly official journal, *National Geographic* magazine.

For many years, the Society has reproduced back issues of the magazine in bound volumes, microfiche, and microfilm. With the advent of CD-ROM technology in recent years, the Society in 1997 produced "The Complete National Geographic" (CNG), a thirty-disc CD-ROM set containing each monthly issue of the magazine for the 108 years from 1888 through 1996. App. 3a. The issues appear chronologically, from the earliest at the beginning of the first disc to the latest at the end of the thirtieth disc. There are no changes to the content, format, or appearance of any issue reproduced in the CD-ROM set. *Id.* at 4a. Every page of every issue remains as it was in the original print version, including all page arrangements, articles, photographs, graphics, advertising, and attributions. *Id.*

The CNG, like any other CD-ROM product, also contains a computer program. *Id.* at 4a-5a. That program not only compresses and decompresses the images, but also allows the user to search an electronic version of *National Geographic*'s traditional subject, title, and author-based index. *Id.* An article, once retrieved through the search function, appears just as it did in the original paperbound magazine, with all of the

surrounding materials from the original magazine. The program does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way. *Id.* at 4a.

Whenever a CNG disc is inserted into a CD-ROM drive, it automatically launches an introductory sequence of ten past covers of the magazine that fade into one another. *Id.* at 3a-4a. This "moving covers" sequence, which is accompanied by music and sound effects, lasts for 25 seconds. *Id.* Following the initial installation, a user can stop the moving covers sequence at any time with the click of a button.

After placing the CNG on the market, the Society obtained a copyright registration for the product from the United States Copyright Office. Under settled law and practice, that Office considers a CD-ROM like the CNG to be a "multimedia work." As relevant here, an applicant for a copyright in such a work must "[g]ive a brief, general statement of the material that has been added to this work *and in which copyright is claimed.*" *Id.* at 12a (emphasis added). Accordingly, the Society claimed a copyright in the "[b]rief introductory audiovisual montage." *Id.* The Copyright Office registered the CNG copyright effective July 14, 1998. *Id.* at 18a.

Respondent Jerry Greenberg is a freelance photographer whose pictures were published in the January 1962, February 1968, May 1971, and July 1990 issues of *National Geographic* magazine. *Id.* at 2a-3a. Greenberg's photograph of a diver appeared on the cover of the January 1962 issue, and that cover was one of the ten "moving covers" in the CNG's introductory sequence. *Id.* at 3a-4a.

Greenberg and his wife, respondent Idaz Greenberg, filed this lawsuit in December 1997, alleging that the Society's reproduction of his photographs in the CNG infringed their copyrights. (Respondents did not dispute that the Society was entitled to publish Greenberg's photographs in *National Geographic* magazine in the first instance.) The lawsuit named

as defendants not only the Society, but also its subsidiary, petitioner National Geographic Enterprises, Inc., which developed the CNG product, and petitioner Mindscape, Inc., which distributed the product. *Id.* at 6a. Respondents alleged that the liability of these latter defendants was "at least vicarious." *Id.* at 7a n.6.

Petitioners moved for summary judgment on the ground that Section 201(c) of the Copyright Act authorizes the publisher of a collective work like *National Geographic* magazine to reproduce that collective work in a new medium like CD-ROM. The district court (Lenard, J., S.D. Fla.) granted the motion, because "th[e] original selection and arrangement" of the print magazine "is preserved in The Complete National Geographic." *Id.* at 42a. The court specifically rejected respondents' argument that "the image display and Society logo at the beginning of each disc, the credit display at the end of each disc, and Society's selection of one edition of the many editions of the magazine, render The Complete National Geographic more than trivially different from [the print] magazines." *Id.* at 42a-43a. The court did not reach petitioners' separate argument that the use of the January 1962 cover in the "moving covers" sequence was either *de minimis* or fair use. *See id.* at 43a n.*.

The Eleventh Circuit reversed. The court began its analysis by noting that Section 201(c) grants publishers "only a privilege, not a right," and asserting that the privilege must be "narrowly constru[ed]" when balanced against the author's rights. *Id.* at 9a. The court then held that Section 201(c) does not allow petitioners to reproduce back issues of *National Geographic* magazine in the CNG, because the CNG itself is a "new" collective work. *Id.* at 9a-13a. The court made no effort to tie that holding to the language of the statute, which nowhere states that the privilege does not apply to "new" collective works. Instead, the court relied entirely on a passage in the legislative history that "*the publisher could not* revise the contribution itself or *include it in* a new anthology or *an*

entirely different magazine or *other collective work*." *Id.* at 10a (quoting H.R. Rep. No. 94-1476, at 122-23 (1976)) (emphasis added by the court). According to the court, "in creating a new work the Society forfeited any privilege that it might have enjoyed" under Section 201(c). App. 12a-13a (emphasis and footnote omitted). The court separately held that the use of the January 1962 cover in the "moving covers" sequence was neither *de minimis* nor fair use, and thus additionally infringed respondents' copyright in the cover photograph. *Id.* at 13a-16a.

The Eleventh Circuit buttressed its conclusion that CNG was a "new" collective work by noting that the Society had "registered its claim of copyright in the CNG" with the Copyright Office. *Id.* at 11a. The court then focused on the Society's registration application, and especially on the subpart requesting "a brief, general statement of the material that has been added to this work *and in which copyright is claimed*." *Id.* at 12a (emphasis added). As the court noted, the Society responded to that request by stating "'Brief introductory audiovisual montage.'" *Id.* The court then faulted the Society for having "failed to indicate the . . . critical . . . element of the new work, the [computer] Program," *id.* at 12a n.13—*even though the Society never claimed a copyright in that program.* Indeed, the court accused the Society of thereby "perpetrat[ing] a fraud on the Copyright Office." *Id.* The court attached the Society's copyright registration application as an appendix to its published opinion. *Id.* at 18a-19a.

The court concluded by ordering the entry of judgment in respondents' favor. *Id.* at 16a. In addition, the court declared respondents to be the "prevailing part[ies]" on appeal, and "therefore . . . entitled to an award of costs and attorneys fees." *Id.*

Petitioners then filed a petition for rehearing and rehearing *en banc*, noting among other things that this Court was currently considering the correct interpretation of Section 201(c) in *Tasini*. The petition also noted that the court's

accusation of "fraud on the Copyright Office" was baseless, because the computer program was not "material . . . *in which copyright is claimed*" by the Society. *Id.* at 12a (emphasis added). Finally, the petition noted that the reversal of summary judgment in petitioners' favor did not automatically entitle respondents to judgment in their favor, and that in any event even "prevailing parties" in copyright cases are not automatically entitled to attorneys' fees under *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994).[1]

Several weeks after the petition was filed, the Eleventh Circuit *sua sponte* issued a "corrected" opinion (backdated to the date of the original opinion) deleting the direction to enter judgment and award attorneys' fees in respondents' favor. App. 16a. The court, however, did not dispose of the pending petition for rehearing and rehearing *en banc*.

Petitioners promptly filed a letter amending the pending petition by withdrawing those portions rendered moot by the subsequent "corrected" opinion. Petitioners also attached a letter they had received from the Copyright Office disputing the Eleventh Circuit's conclusion that National Geographic had committed "fraud" in its CNG registration application. Respondents moved to strike petitioners' letter and the attached letter from the Copyright Office. Even before petitioners' time to respond to that motion had expired, the court granted the motion. App. 36a.

On June 8, 2001, while *Tasini* remained pending in this Court, the Eleventh Circuit denied the petition for rehearing and rehearing *en banc*. App. 22a-23a. This petition follows.

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[1] A number of publishers, including the Magazine Publishers of America, Inc., the Newspaper Association of America, Inc., Gannett Co., Inc., Hachette Filipacchi Magazines, Inc., The New York Times Company, Time Inc., Times Mirror Co., and Tribune Company, timely moved for leave to file an *amicus* brief in support of the petition for rehearing and rehearing *en banc*. The court, however, denied the motion without explanation. App. 24a.

REASONS FOR GRANTING THE WRIT

I. THE ELEVENTH CIRCUIT ERRED, AND CREATED A CONFLICT WITH THIS COURT'S SUBSEQUENT DECISION IN *TASINI*, BY HOLDING THAT A PUBLISHER'S EXACT, IMAGE-BASED REPRODUCTION OF A COLLECTIVE WORK IN CD-ROM FORMAT INFRINGES THE COPYRIGHTS OF FREELANCE CONTRIBUTORS.

This is a straightforward case of statutory interpretation. The Copyright Act grants publishers of collective works a privilege to reproduce freelance contributions as part of the "particular collective work" to which the freelancers contributed, 17 U.S.C. § 201(c), and that is just what National Geographic has done here. The CNG provides an exact, image-based reproduction of each issue of *National Geographic* magazine in CD-ROM format, so that (as the Eleventh Circuit acknowledged) "[w]hat the user of the CNG sees on his computer screen . . . is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text." App. 4a. Because "[e]very cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine," *id.*, National Geographic has simply reproduced freelance contributions in a new medium as part of the "particular collective work" to which the freelancers contributed—or, at least, as part of "any revision of that collective work." 17 U.S.C. § 201(c). That is the beginning and the end of this case.

This Court's opinion in *Tasini* confirms this straightforward analysis. At issue in *Tasini* was the reproduction of individual freelance contributions in three electronic databases: (1) LEXIS/NEXIS, (2) the New York Times OnDisc (NTYO), and (3) General Periodicals OnDisc (GPO). 121 S. Ct. at 2385-86. The Court held that such reproduction fell outside the scope of Section 201(c) because in each database "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented." *Id.* at

2384. With respect to LEXIS/NEXIS and NYTO, both of which store individual articles from collective works in text-only format, "an article appears to a user without the graphics, formatting, or other articles with which the article was initially published." *Id.* at 2391. And with respect to GPO, which stores individual articles from collective works in image-based format, "the article appears with the other materials published on the same page or pages, but without any material published on other pages of the original periodical." *Id.*

Tasini confirms, however, that with respect to a product like the CNG, which includes an exact, image-based reproduction of *every page* of a particular collective work, the Section 201(c) privilege applies. In this situation, each freelance contribution is "presented to, and perceptible by, the user" of the product in its "original context" as "part of the collective work to which the author contributed." 121 S. Ct. at 2390-92. Indeed, the *Tasini* Court went out of its way to note that the reproduction of a collective work in microfilm or microfiche *does* qualify for the privilege. As the Court explained, "articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper." *Id.* at 2391. Although "the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on [an] Article, to the exclusion of surrounding material," the dispositive fact remains that the user "encounters the Article in context." *Id.* In this critical regard, the CNG is indistinguishable from microfilm or microfiche.

Indeed, the *Tasini* Court specifically reaffirmed the bedrock principle that the Copyright Act is media-neutral, and "the transfer of a work between media does not alter the character of that work for copyright purposes." *Id.* at 2392 (internal quotation and brackets omitted). Thus, a publisher is entitled to reproduce collective works in new media, as long as it reproduces "intact periodicals," not "individual articles." *Id.* That is why the "crucial fact" in *Tasini* was that "the Databases . . . store and retrieve articles *separately* within a vast domain

of diverse texts," rather than leaving the articles within the context of the particular collective works to which the authors contributed. *Id.* at 2393 (emphasis added). The privilege turns on the preservation of the integrity of the original collective work, not the technology of the medium of reproduction.

The Eleventh Circuit, however, applied an entirely different—and erroneous—analysis. Rather than focusing on whether the CNG presents freelance contributions to users in the "original context" of "the collective work to which the author contributed," *Tasini*, 121 S. Ct. at 2390-92, the court focused instead on whether the CNG itself could be characterized as a "new" collective work, App. 9a-13a. Thus, while acknowledging that "[e]very cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine," *id.* at 4a, the court concluded that Section 201(c) did not apply because the CNG itself was a "new" collective work. According to the Eleventh Circuit, the crucial fact here is that the CNG includes not only reproductions of past issues of *National Geographic* magazine, but also an independently copyrightable introductory sequence and computer program. *Id.* at 9a-10a. The addition of these elements of originality, the court asserted, rendered the CNG itself a "new" collective work outside the scope of Section 201(c). *Id.* at 9a-13a. Indeed, the court attempted to distinguish the CNG from microfilm and microfiche by asserting that the computer programs necessary to run a CD-ROM "are themselves the subject matter of copyright, and may constitute original works of authorship." *Id.* at 11a n.12.

The Eleventh Circuit's focus on whether the CNG is a "new" collective work with independently copyrightable features is flatly inconsistent with *Tasini*. The *Tasini* Court, as noted above, framed the inquiry under Section 201(c) on how "the Articles [are] presented to, and perceptible by, the *user* of the Databases." 121 S. Ct. at 2390 (emphasis added); *see also id.* at 2391 n.9 ("This case . . . is about what is presented to the general public in the Databases."). As long as the user

perceives individual freelance contributions as a part of the particular collective work to which the freelancers contributed, it is immaterial whether the publisher has created a "new" work with independently copyrightable features. As the Eleventh Circuit itself acknowledged, a user typically does not know or care about the existence of an independently copyrightable computer program. *See* App. 12a n.13.

Indeed, if the creation of a "new" collective work with independently copyrightable elements were legally dispositive, this Court's analysis in *Tasini* was all wrong and gratuitous. All three databases at issue in *Tasini* (LEXIS/NEXIS, NYTO, and GPO) include computer programs that, like the CNG's computer program, are independently copyrightable. 121 S. Ct. at 2385-86. Each of these databases, thus, could be characterized as a "new" collective work under the Eleventh Circuit's analysis. But the *Tasini* Court never suggested that this point was dispositive. To the contrary, the Court gave this point *no weight whatsoever* in its legal analysis. Rather, as noted above, the *Tasini* Court focused on the entirely different question whether the databases presented individual freelance contributions to the user in "isolation," or instead in "the context the original print publication presented." *Id.* at 2384; *see also id.* ("The publishers are not sheltered by § 201(c), we conclude, *because the databases reproduce and distribute articles standing alone and not in context.*") (emphasis added).

The Eleventh Circuit's focus on the existence of independently copyrightable elements in the CNG (rather than the perceptions of the end user) also violates the bedrock principle of media-neutrality specifically reaffirmed in *Tasini*. The reproduction of a collective work in new media will almost invariably entail the addition of some independently copyrightable element, such as a computer program. Indeed, the very advantages of new media (including, but not limited to, CD-ROM) often consist of independently copyrightable features. Thus, one of the reasons that CD-ROM is such a powerful medium is that its copyrightable computer program

compresses images (allowing the reproduction of vast quantities of information in a limited space), and performs an electronic search function. If the presence of such a program were sufficient to defeat the privilege, then Section 201(c) would *never* permit the reproduction of collective works in CD-ROM or other electronic media. But a "particular collective work" does not cease to be a "particular collective work" just because it is reproduced in a new medium that includes independently copyrightable elements. The Copyright Act is not a Luddite law, and does not prevent publishers from using technological advances to reproduce their collective works in new media.

Indeed, the Eleventh Circuit's analysis would prevent a publisher like National Geographic from reproducing a collective work even in "old" media (such as microfilm and microfiche) because these media too include independently copyrightable elements, such as an introductory page and a subject, title, and author-based index. As noted above, however, the *Tasini* Court specifically recognized that Section 201(c) allows publishers to reproduce their collective works in these media. As long as individual freelance contributions are presented to the user in the context of the original collective work, the addition of intellectual property in any particular medium of reproduction is immaterial.

At bottom, the Eleventh Circuit's analysis ignores the fundamental balance struck by Section 201(c) and reaffirmed in *Tasini*. That provision "accommodate[s]" the author's copyright in an *individual* work and the publisher's copyright in the *collective* work. 121 S. Ct. at 2389; *see also* H.R. Rep. No. 94-1476, at 122-23 (1976) (Section 201(c) "represents a fair balancing of equities" between authors and publishers). Indeed, the publishers' privilege to reproduce its collective work is the "essential counterpart" to the authors' copyright in their individual contributions. *Id.* The Eleventh Circuit's analysis, however, is based on the premise that the publishers' privilege is to be "narrowly constru[ed]" as against "the

constitutionally-secured rights of the author/contributor," App. 9a—a premise not only absent from *Tasini*, but affirmatively inconsistent with the fundamental balance reaffirmed in that decision. By holding that a publisher violates a freelancer's copyright by reproducing an entire *collective* work in any format that includes new elements of originality, the Eleventh Circuit missed the whole point of the statute.

The Eleventh Circuit's analysis and holding are not only inconsistent with *Tasini*, but wholly unrooted in the statutory text. As noted above, the statute specifically authorizes publishers to reproduce freelance contributions as part of the "particular collective work" to which the freelancer contributed, or "any revision of that collective work." 17 U.S.C. § 201(c). The statute nowhere says that this privilege does not apply with respect to reproductions that include independently copyrightable elements. The Eleventh Circuit did not suggest otherwise; to the contrary, the court based its analysis and holding entirely on a passage in the legislative history. (Indeed, the court attached the legislative history as an appendix to its opinion, App. 20a-21a.)

As an initial matter, the Eleventh Circuit's approach to statutory interpretation is itself erroneous, because legislative history is a tool for resolving statutory ambiguity, not a substitute for statutory text. *See, e.g., Shannon v. United States*, 512 U.S. 573, 583-84 (1994) ("[C]ourts have no authority to enforce a principle gleaned solely from legislative history that has no statutory reference point.") (internal quotation and brackets omitted). And, even more to the point, the cited passage from the legislative history does not support the Eleventh Circuit's conclusion.

The court relied on the following passage from the legislative history:

> The basic presumption of section 201(c) is fully consistent with present law and practice, and

> represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; *the publisher could not* revise the contribution itself or *include it in* a new anthology or *an* entirely different magazine or *other collective work.*

App. 10a (quoting H.R. Rep. No. 94-1476, at 122-23 (1976)) (emphasis added by the court).

According to the Eleventh Circuit, these italicized words from the legislative history mean that the publisher of an "other collective work" (*i.e.*, a "new" collective work) necessarily loses the privilege. That is simply not true. To the contrary, the passage underscores the importance of the publisher's privilege (the "essential counterpart" to the author's copyright), and provides two examples of what publishers can and cannot do within the scope of that privilege. According to the passage, Section 201(c) allows a publisher to (1) "reprint a contribution from one issue in a later issue of its magazine," and (2) "reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it," but does not allow the publisher to (1) "revise the contribution itself," or (2) "include it in a new anthology or an entirely different magazine or other collective work."

The Eleventh Circuit seized on the last three words of this passage ("other collective work") to conclude that the statute does not allow a publisher to reproduce a freelance contribution in a new (and independently copyrightable) collective work, even where (as here) that collective work includes an exact image-based reproduction of the original

collective work. But that is not what the passage says. To the contrary, both of the examples of what a publisher *can* do entail the creation of new (and independently copyrightable) collective works: the publication of "a later issue of its magazine," and the publication of a new edition of an encyclopedia.

That a publisher cannot reproduce an individual freelance contribution in a "new anthology" or "an entirely different magazine or other collective work" simply means (in the words of the statute) that the publisher cannot *remove* the contribution from the "particular collective work" in which it originally appeared. A freelance contribution to *National Geographic* magazine, for example, cannot be reproduced in *The New Yorker*, the Encyclopedia Britannica, or a collection of articles on a particular topic. Contrary to the Eleventh Circuit's conclusion, the passage does not remotely suggest that a publisher cannot include a "particular collective work" in its *entirety* in a new (and independently copyrightable) collective work. The creation of a new collective work (whether or not copyrightable or copyrighted in its own right) is simply not inconsistent with the preservation of the "particular collective work" in which an individual freelance contribution originally appeared. One collective work can form part of another, just as a Sunday magazine forms part of a Sunday newspaper. Thus, a publisher is free to reproduce a "particular collective work" or "any revision of that collective work" in new media (such as microfilm, microfiche, or CD-ROM), regardless of whether the resulting product is itself characterized as a "new" collective work through the addition of new, original elements.

Accordingly, the Eleventh Circuit erred by focusing on whether the CNG itself is a "new" collective work rather than focusing on whether the CNG exploits any individual freelance contribution outside the context of the original collective work. Because the Eleventh Circuit asked the wrong question, it reached the wrong answer. The Section 201(c) privilege

applies here because the CNG preserves intact the integrity of the original print versions of *National Geographic* magazine.[2]

The practical consequences of the Eleventh Circuit's error are enormous. On the most direct level, the decision makes it impossible for publishers to create archives of their collective works in CD-ROM format, because the inevitable addition of independently copyrightable material (such as a computer program) necessarily defeats the privilege. Because it is impossible as a practical matter for those publishers (like National Geographic) that have already created CD-ROM archives of their collective works to reach retroactive license agreements with all of their past freelance contributors, the only solution for such publishers is to withdraw their CD-ROM products from the market. Needless to say, the destruction of a valuable historical archive like the CNG, which has allowed countless persons easy, quick, and inexpensive access to collective works, harms not only National Geographic, but also unknown generations of individuals, students, and scholars.[3]

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[2] The Eleventh Circuit also erred by rejecting petitioners' distinct argument that the use of respondents' January 1962 cover photograph in the introductory montage was permissible under the fair use and *de minimis* doctrines. *See* App. 13a-16a. That rejection was expressly based in part on the court's conclusion that the "moving covers" sequence was "an integral part of a larger, new collective work" outside the scope of Section 201(c). App. 14a. Accordingly, the court's erroneous interpretation of Section 201(c) necessarily infected its fair use and *de minimis* analysis as well, and review of the former issue warrants review of the latter.

[3] Indeed, the CNG is presently sold at retail for less than $100, and grants a user access to all back issues of *National Geographic* magazine (which, in paperbound form, take up an entire room) on thirty discs. The same collection on microfilm, in contrast, takes up 170 rolls of film, and currently sells for $37,000. And a set of 717 microfiche cards reproducing all issues of the magazine since 1978 currently sells for approximately $3,000. Not surprisingly, very few (if any) individuals buy microfilm or microfiche (or the expensive machines necessary to read them) for home use—in sharp contrast to CD-ROM, which is ideal for home use on a personal computer.

And the consequences of the Eleventh Circuit's error are by no means limited to the CD-ROM context. Rather, by holding Section 201(c) inapplicable whenever a collective work is reproduced in a medium that includes independently copyrightable elements, the court essentially rendered the privilege a dead letter for *all* purposes. If an exact, image-based reproduction of a collective work like the CNG violates freelancers' copyrights, then publishers are essentially precluded from reproducing their collective works in *any* new media. That result is especially perverse in an age of rapid technological development, which allows collective works to be stored, retrieved, and searched in new ways that make access to such works more broadly, easily, and inexpensively available to all. And that result, needless to say, undermines copyright's constitutional goal of "promot[ing] the Progress of Science and useful Arts." U.S. Const. art. II, § 8, cl. 8.

Accordingly, as in *Tasini*, this Court should grant *certiorari* to address this issue of such great legal and practical importance. At the very least, the Court should grant *certiorari*, vacate the decision below, and remand for the Eleventh Circuit to reconsider its decision in light of this Court's subsequent decision in *Tasini*.

II. THE ELEVENTH CIRCUIT ERRED BY HOLDING THAT AN APPLICANT FOR A COPYRIGHT REGISTRATION PERPETRATES A "FRAUD" ON THE COPYRIGHT OFFICE WHEN THE APPLICANT DISCLOSES ALL THE INFORMATION THAT THE COPYRIGHT OFFICE REQUIRES.

The Eleventh Circuit separately erred by accusing National Geographic of having "perpetrated a fraud" on the Copyright Office when applying for the CNG's copyright registration. App. 12a n.13. This is not some arcane error of law, but a fundamental "depart[ure] from the accepted and usual course of judicial proceedings," S. Ct. R. 10(a): the accusation is of the utmost gravity, and manifestly erroneous. This Court

should not allow the lower courts to besmirch a litigant's reputation with impunity, especially a litigant like the National Geographic Society, a not-for-profit organization whose very existence depends in large measure on the continued support of its members and benefactors.

As noted above, the Eleventh Circuit concluded that the CNG was a "new" collective work based on the existence of the moving covers sequence and the computer program. App. 9a-13a. The court then noted that "[t]his analysis is totally consistent with the conduct of the Society when it registered its claim of copyright in the CNG," *id.* at 11a, because such registration necessarily presupposes the addition of some element of originality. The court then embarked on a frolic and detour through National Geographic's registration application, which it attached as an appendix to its published decision. In particular, the court focused on "section '6,' subpart 'b,' which requested, 'Material added to this work. Give a brief, general statement of the material that has been added to this work *and in which copyright is claimed.*" App. 12a (emphasis added). In response, the court noted, "the Society wrote 'Brief introductory audiovisual montage.'" *Id.*

Seizing on this answer, the court asserted that "the Society failed to indicate the third, and critical, element of the new work, the [computer] Program." *Id.* at 12a n.13; *see also id.* at 5a ("No reference was made to, nor was there any disclosure of, the copyrightable Mindscape Program or the two pre-existing, copyrightable sub-programs that it incorporates, all of which are also components of the CNG."). The court then accused the Society of having "perpetrated a fraud on the Copyright Office"—albeit, "[g]iving the Society the benefit of the doubt," perhaps "not . . . intentionally." *Id.* at 12a n.13. (A most curious accusation, given that fraud is an intentional tort. *See, e.g.*, 37 C.J.S. Fraud § 28 (1997).)

The Eleventh Circuit's accusation of "fraud on the Copyright Office" is manifestly erroneous. (One reason for this error may be that this issue was never briefed or argued by

any of the parties prior to the court's decision, and the court never solicited the views of the Copyright Office.) As explained by the very registration form that the Eleventh Circuit quoted and published, subpart 6(b) requires the applicant to list only "the material that has been added to this work *and in which copyright is claimed.*" App. 12a (emphasis added); *see also* Copyright Registration for Multimedia Works 4 (1999), available online at www.loc.gov/copyright/circs/circ55.pdf (instructing an applicant to fill out subpart 6(b) by "[b]riefly describ[ing] all the new copyrightable authorship *that is the basis of the present registration*") (emphasis added); *id.* at 2 (noting that "[a] separate registration is required . . . for any element of a multimedia kit that is . . . claimed by someone other than the copyright claimant for the other elements"). Because National Geographic did not claim a copyright in the computer program, it was neither necessary nor appropriate for National Geographic to refer to that program in that subpart.

Petitioners brought this error to the Eleventh Circuit's attention in their petition for rehearing and rehearing *en banc*. Several weeks later, while that petition remained pending, National Geographic received a detailed letter from the General Counsel of the Copyright Office confirming National Geographic's interpretation of the registration application. App. 27a-35a. The letter explains that the court's accusation of fraud on the Copyright Office is "based on a misunderstanding of copyright registration practices," and that "there can be no question of any attempt to perpetrate a fraud on the Copyright Office, and the court's speculation in footnote 13 of the opinion is inconsistent with the Copyright Office registration record for this particular work." App. 35a, 31a; *see also id.* at 27a ("[T]he court's remarks about the National Geographic Society's possible fraud on the Copyright Office appear to reveal a misunderstanding of Copyright Office registration practices."); *id.* at 28a ("[W]e find that the National Geographic Society's application complied with the Office's requirements for registration, and that there is no reason to

conclude that the application misled the Office in any way."); *id.* at 34a ("The National Geographic Society had no obligation to disclose or assert a copyright claim in the software.").[4]

National Geographic immediately forwarded the Copyright Office letter to the Eleventh Circuit. *Id.* at 25a-26a. Respondents, however, moved to strike the filing. Even before the expiration of petitioners' time to respond to the motion, the court granted the motion. *Id.* at 36a. Several weeks later, the court denied the pending petition for rehearing and rehearing *en banc* without deleting or otherwise modifying the accusation of fraud on the Copyright Office.

This Court should not allow the Eleventh Circuit's baseless accusation on a matter of such gravity to stand. It is bad enough that the court *sua sponte* accused National Geographic of having "perpetrated a fraud on the Copyright Office," App. 12a n.13, when the very registration application quoted by the court makes it perfectly clear that only material "in which copyright is claimed" need be set forth, *id.* at 12a. But it is another thing altogether for the court to refuse to correct such a manifest error once brought to its attention, especially where—as here—the court's analysis is disputed by the very federal agency against which the court deemed the "fraud" to have been perpetrated. Congress entrusted the complex responsibility of administering copyright registration procedures to the Copyright Office, not the Eleventh Circuit. Neither litigants nor federal agencies should be subject to such judicial caprice.

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[4] Indeed, the Copyright Office explained that it is self-understood that "when works of authorship embodied in CD-ROM format are submitted for registration, computer programs may be included on the same CD-ROM, and that use of those computer programs may be necessary in order for a user to gain access to the work of authorship in which copyright is claimed." App. 32a. Accordingly, "it is not necessary in such cases that the application for copyright registration include a claim of copyright in the software." *Id.*

The Eleventh Circuit's holding merits this Court's review because the decision below is misleading, confusing, and leaves copyright registration applicants in the dark about what to disclose. Under the Eleventh Circuit's view, an applicant for a copyright registration in a multimedia work *must* include a copyrightable computer program in its application, even if the applicant makes no claim to the copyright; under the Copyright Office's view, the applicant *cannot* include such a program if the applicant does not claim the copyright. *See, e.g.,* Copyright Registration for Multimedia Works 2 ("A separate registration is required . . . for any element of a multimedia kit that is . . . claimed by someone other than the copyright claimant for the other elements."). Copyright registrants are thus faced with the Hobson's choice of following either the Copyright Office or the Eleventh Circuit in filling out a copyright registration application. In addition, the decision below subjects existing valid registrations in multimedia works to invalidation. If ever there were an issue calling for this Court's exercise of its "supervisory power" to correct a decision that has "so far departed from the accepted and usual course of judicial proceedings," S. Ct. R. 10(a), this is it.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari.*

Respectfully submitted,

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

July 30, 2001

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APPENDIX A

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 00-10510

D.C. Docket No. 97-03924-CV-JAL

JERRY GREENBERG,
IDAZ GREENBERG,

Plaintiffs-Appellants,

versus

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia Corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, MINDSCAPE, INC.,
a California corporation,

Defendants-Appellees.

Appeal from the United States District Court
for the Southern District of Florida

(March 22, 2001)

Before ANDERSON, Chief Judge, and TJOFLAT and BIRCH, Circuit Judges.

BIRCH, Circuit Judge:

This appeal requires us, as a matter of first impression in this circuit, to construe the extent of the privilege afforded to the owner of a copyright in a collective work to reproduce and distribute the individual contributions to the collective work "as part of that particular collective work, any revision of that

collective work, and any later collective work in the same series" under 17 U.S.C. § 201(c).[1] In this copyright infringement case, the district court granted the defendants' motion for summary judgment, holding that the allegedly infringing work was a revision of a prior collective work that fell within the defendants' privilege under § 201(c). Because we find that the defendants' product is not merely a revision of the prior collective work but instead constitutes a new collective work that lies beyond the scope of § 201(c), we **REVERSE**.

I. BACKGROUND

The National Geographic Society ("Society") purports to be the world's largest nonprofit scientific and educational organization at approximately 9.5 million members, and is responsible for the publication of National Geographic Magazine ("Magazine"). Through National Geographic Enterprises, a wholly owned, for-profit subsidiary, the Society also produces television programs and computer software, along with other educational products. In order to acquire photographs for the Magazine and its other publications, the Society hires freelance photographers on an independent-contractor basis to complete specific assignments.

Jerry Greenberg is a photographer who completed four photographic assignments for the Society over the course of 30 years. Photographs from the first three assignments were published in the January 1962, February 1968, and May 1971 issues of the Magazine, respectively. The terms of Greenberg's employment for these assignments were set out in a series of relatively informal letters. Greenberg received compensation consisting of a daily fee, a fee based on the number of photographs published, and payment of expenses, and in return the Society acquired all rights in any photograph taken on the

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[1] Hereafter, all references to statutory sections ("§") will be to Title 17 of the United States Code, unless indicated otherwise.

jobs that was ultimately selected for publication in the Magazine. In 1985, at Greenberg's request, the Society reassigned its copyrights in the pictures from these three jobs back to Greenberg. Greenberg's fourth hire for the Society appeared in the July 1990 issue of the Magazine, but the agreement for this job was more detailed than its predecessors. The principle terms of the fourth agreement were similar to those of the first three; however, in this agreement it was explicitly provided that all rights that the Society acquired in the photographs from the job would be returned to Greenberg 60 days after the pictures were published in the Magazine.

In 1996, the Society, in collaboration with Mindscape, Inc., began the development of a product called "The Complete National Geographic" ("CNG"), which is a 30 CD-ROM library that collects every[2] issue of the Magazine from 1888 to 1996 in digital format. There are three components of the CNG that are relevant to this appeal: (1) the moving covers sequence ("Sequence"); (2) the digitally reproduced issues of the Magazine themselves ("Replica"); and (3) the computer program that serves as the storage repository and retrieval system for the images ("Program").

The Sequence is an animated clip that plays automatically when any disc from the CNG library is activated. The clip begins with the image of an actual cover of a past issue of the Magazine. This image, through the use of computer animation, overlappingly fades ("morphs") into the image of another cover, pauses on that cover for approximately one second, and then morphs into another cover image, and so on, until 10 different covers have been displayed. One of the cover images used in the moving covers sequence is a picture of a diver that

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[2] The Society publishes multiple regional and international editions of each issue of the Magazine. These various editions differ from one another in the language in which they are written and the advertisements that are printed. The CNG includes only one representative edition of each issue.

was taken by Greenberg in 1961. The entire sequence lasts for 25 seconds, and is accompanied by music and sound effects.

The collected issues of the Magazine, which are, of course, the CNG's *raison d'etre,* were converted to digital format through a process of scanning each cover and page of each issue into a computer. What the user of the CNG sees on his computer screen, therefore, is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text. Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine. The user can print out the image of any page of the Magazine, but the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.

The Program, which was created by Mindscape, is the element of the software that enables the user to select, view, and navigate through the digital "pages" of the Magazine Replica on the CD-ROM. In creating the Program for the CNG, Mindscape incorporated two separate programs: the CD Author Development System ("CDA"), which is a search engine created by Dataware Technologies, Inc.; and the PicTools Development Kit ("PicTools"), which is a program for compressing and decompressing images that was created by Pegasus Imaging Corp.[3] The CNG package contains a "shrink-

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[3] Mindscape indicates that it has not registered a claim of copyright in the Program, which is manifestly copyrightable. *See* §§ 101 (defining "computer program"), 102; *Montgomery v. Noga,* 168 F.3d 1282, 1288 (11th Cir. 1999). However, copyright arises by operation of law upon fixation of an original work of authorship in a tangible medium of expression, which has clearly occurred in the case of the Program. *See* § 102; *Montgomery,* 168 F.3d at 1288. Moreover, Mindscape has represented to this court that two component elements of the Program, the CDA and PicTools, each of which are separately copyrightable computer programs, have been registered with the Copyright Office by Dataware Technologies, Inc., and Pegasus Imaging Corp., respectively. Because it consists of at least two other individually copyrighted works, the Program

(continued...)

wrap" license agreement in which "all rights [in the Program] not expressly granted are reserved by Mindscape or its suppliers." Without the Program, the Replica could still be stored on a CD-ROM, but the individual "pages" of the Magazine would not be efficiently accessible to the user of the CNG.

Prior to placing the CNG on the market, the Society dispatched a letter to each person who had contributed to the Magazine. This letter informed the contributors about the CNG product and stated the Society's position that it would not provide the contributors with any additional compensation for the digital republication and use of their works. Greenberg contends that he responded to this notice through counsel and objected to the Society's use of his photographs in the CNG, but he received no response from the Society.

The Society sought registration for its claim of copyright for the CNG in 1998, but noted 1997 as the year of its completion. On the registration form,[4] the Society indicated that the "nature of authorship" included photographs, text, and an "introductory audiovisual montage." The Society claimed that the work had not been registered before, but indicated that it was a derivative work, namely a "compilation of pre-existing material primarily pictorial," to which a "brief introductory audiovisual montage" had been added. No reference was made to, nor was there any disclosure of, the copyrightable Mindscape Program or the two pre-existing, copyrightable sub-programs that it incorporates, all of which are also components of the CNG. The box in which the CNG is packaged and each individual CD-ROM bear the mark "© 1997 National

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[3] (...continued)
meets the definition of both a "compilation" and a "collective work" under § 101 of the Act.

[4] A copy of the registration form (application), which when approved by the Copyright Office became the registration certificate, is attached hereto as Appendix A.

Geographic Society"—indicating the creation of a new work of authorship in 1997.

Greenberg initiated an infringement action against the Society, National Geographic Enterprises, and Mindscape, alleging five counts of copyright infringement, two of which are relevant here: count "III" addressed the Society's reuse of Greenberg's photographs in the CNG, generally, and count "V" specifically addressed the use of his diver photograph in the Sequence. The Society, together with the two other defendants, moved for summary judgment on counts III-V, arguing that it had a privilege under § 201(c) to reproduce and distribute Greenberg's photographs in the CNG because it owned the copyright in the original issues of the Magazine in which the photographs appeared.[5] Greenberg filed a cross-motion for summary judgment on count III. The district court, relying on the district court opinion in *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), *rev'd*, 206 F.3d 161 (2d Cir. 2000), *cert. granted*, 69 U.S.L.W. 3312, 3316 (U.S. Nov. 6, 2000) (No. 00-201), held that the CNG constituted a "revision" of the paper copies of the Magazine that was within the Society's privilege under § 201(c), and accordingly granted summary judgment for all of the defendants on counts III-V. The district court later dismissed counts I and II, which did not relate to the CNG, at the parties' joint request. The Greenbergs appeal the district court's judgment only as to counts III and V.

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[5] There is no evidence in the record that would support the theory that National Geographic Enterprises or Mindscape, neither of which has a copyright interest in the original issues of the Magazine, somehow are privy to the privilege in § 201(c) enjoyed by the Society.

II. DISCUSSION

To evaluate the claims of infringement leveled by Greenberg against the defendants,[6] we must interpret and apply § 201(c) of the Act. That section constitutes the sole basis and defense of the Society's use of Greenberg's copyrighted photographs. In all cases involving copyright law, we understand that any interpretation and application of the statutory law must be consistent with the copyright clause of the United States Constitution; specifically, the eighth clause of the eighth section of Article I. That clause is a limitation, as well as a grant, of the copyright power.[7] The copyright clause,

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[6] In the Amended Complaint, Greenberg refers to Mindscape's and National Geographic Enterprises's liability as "at least vicarious." We construe this as an allegation of contributory copyright infringement. A contributory copyright infringer is "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another." *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990) (citations omitted). Accordingly, there can be no contributory infringement without a finding that there was direct copyright infringement by another party. *Id.* Further, the CNG appears to be a "joint work," which is defined under § 101 as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." Here the two "authors," the Society and Mindscape ("authors" under the legal fiction created in § 201(b)), clearly intended their contributions of the Sequence, Replica, and Program to function and be presented as a unitary whole. The CNG also fits the definition of a "collective work" under § 101; that is, "a work . . . in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." The concept of the "collective work" is included within the term "compilation," which is defined in § 101 as "a work formed by the collection and assembling of preexisting materials . . . that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." Whether the CNG is considered a "joint work" or a "collective work" makes no difference in our analysis because under each definition, a work results that is copyrightable as an entity separate and distinct from its constituent, pre-existing, separately copyrightable contributions.

[7] *See* Paul J. Heald and Suzanna Sherry, "Implied Limits on the

(continued...)

consisting of twenty-four words crafted by our founding fathers, is the Rosetta Stone for all statutory interpretation and analysis. Accordingly, it is upon that predicate that we examine § 201(c) in the context of this case.[8]

The Society conceded that it has used Greenberg's photographs in a way that is inconsistent with his exclusive rights as an author under § 106.[9] However, the Society

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[7] (...continued)
Legislative Power: the Intellectual Property Clause as an Absolute Constraint on Congress," 2000 U. Ill. L. Rev. 1119 (2000).

[8] Appreciation of fundamental principles is required in all areas of the law, but is particularly important in the copyright arena. As observed by Professor L. Ray Patterson's opening remarks in his insightful article entitled "Understanding the Copyright Clause," 47 J. COPYRIGHT SOC'Y 365 (2000):

> Probably few industries as large as the copyright industry have rested on a legal foundation as slim as the twenty-four words of the copyright clause. And probably no foundation of comparable importance has been so little understood and so often ignored. This is all the more surprising because the components of the copyright industry-information/learning/entertainment-are so important to a free society, and because the history of the copyright clause is so well documented.

Id. at 365. The copyright clause provides: "The Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings." U.S. Const. art. I, § 8, cl. 8.

[9] Section 106 reserves to the owner of a copyright the rights: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the
(continued...)

contends that it is privileged to make such use of the photographs under § 201(c), and therefore does not violate such exclusive rights and thus is not an infringer under § 501(a). Subpart "c" of § 201, entitled "Ownership of Copyright," provides:

> **(c) Contributions to Collective Works.** Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

In the context of this case, Greenberg is "the author of the contribution" (here each photograph is a contribution) and the Society is "the owner of copyright in the collective work" (here the Magazine). Note that the statute grants to the Society "only [a] privilege," not a right. Thus the statute's language contrasts the contributor's "copyright" and "any rights under it" with the publisher's "privilege." This is an important distinction that militates in favor of narrowly construing the publisher's privilege when balancing it against the constitutionally-secured rights of the author/contributor.

The Society argues that its use of Greenberg's photographs constitutes a "revision" of the Magazine ["that collective work"], referring to the CNG as the compendium of over 1,200 independent back issues; in copyright terms, a collective work of separate and distinct collective works, arranged in

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[9] (...continued)
case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

chronological order.[10] Assuming *arguendo,* but expressly not deciding, that 201(c)'s revision privilege embraces the entirety of the Replica portion of the CNG (the 1,200 issues, as opposed to each separate issue of the Magazine), we are unable to stretch the phrase "that particular collective work" to encompass the Sequence and Program elements as well. In layman's terms, the instant product is in no sense a "revision." In this case we do not need to consult dictionaries or colloquial meanings to understand what is permitted under § 201(c). Congress in its legislative commentary spelled it out in the concluding paragraph of its discussion of § 201(c) (which is identical in both the Senate and House versions):[11]

> The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it, *the publisher could not* revise the contribution itself or *include it in* a new anthology or *an* entirely different magazine or *other collective work.*

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[10] It does not satisfy the definition of "compilation" since inclusion of all issues of a publication in chronological order does not satisfy the minimum creativity necessary for the selection, coordination, or arrangement that would result in an original work of authorship. *See Warren Publ'g, Inc. v. Microdos Data Corp.,* 115 F.3d 1509, 1518-19 (11th Cir. 1997) (en banc) (holding that work incorporating "entire relevant universe" did not exhibit sufficient creativity in selection to merit copyright protection as a compilation).

[11] A reproduction of the entire discussion in the House and Senate Reports is set out in Appendix B.

H.R. Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 (emphasis added).

As discussed above, the CNG is an "other collective work" composed of the Sequence, the Replica, and the Program. However, common-sense copyright analysis compels the conclusion that the Society, in collaboration with Mindscape, has created a new product ("an original work of authorship"), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).[12]

This analysis is totally consistent with the conduct of the Society when it registered its claim of copyright in the CNG (under the title "108 Years of National Geographic on CD-ROM"). Under section "5" of the copyright registration form, in response to the question: "Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?"; the Society replied, "No." Accordingly, this was a new work. Registrations had already been made relative to individual issues of the Magazine. Under section

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[12] The Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium; specifically, digital format. As discussed in the text, however, this case is both factually and legally different than a media transformation. The Society analogizes the digitalization of the Magazine to the reproduction of the Magazine on microfilm and microfiche. While it is true that both the digital reproductions and the microfilm/microfiche reproductions require a mechanical device for viewing them, the critical difference, from a copyright perspective, is that the computer, as opposed to the machines used for viewing microfilm and microfiche, requires the interaction of a computer program in order to accomplish the useful reproduction involved with the new medium. These computer programs are themselves the subject matter of copyright, and may constitute original works of authorship, and thus present an additional dimension in the copyright analysis. Because this case involves not only the incorporation of a new computer program, but also the combination of the Sequence and the Replica, we need not decide in this case whether the addition of only the Program would result in the creation of a new collective work.

"6," subpart "a," the Society described the work (the CNG) as a "Compilation of pre-existing material primarily pictorial." Under section "6," subpart "b," which requested, "Material added to this work. Give a brief, general statement of the material that has been added to this work and in which copyright is claimed," the Society wrote "Brief introductory audiovisual montage." *See* Appendix A.[13] Thus, even the Society admitted that the registered work, the CNG, was a compilation. Recall that a collective work is included in the definition of compilation and embraces those works wherein its separate components are each themselves copyrightable-as are the Sequence, Replica, and Program (the "pre-existing materials" referred to in part [only the Replica was disclosed] by the Society in section "6."). Accordingly, in the words of the legislative report, "the publisher [the Society] could not . . . include [the contribution (the photographs)] in a new anthology . . . or other collective work [the CNG]." Thus in creating a new work the Society forfeited any privilege that it *might*[14]

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[13] As noted earlier, the Society failed to indicate the third, and critical, element of the new work, the Program. While the storage and retrieval system may be "transparent" to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user. Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office.

[14] We indicate "*might*" because a persuasive argument can be made that when the Replica portion of the CNG was converted from text and picture images on a page to electronic, digital format, the statutory definition of a "derivative work" was not satisfied. A "derivative work" is defined under § 101 as:

> a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, *or any other form in which a work may be recast, transformed*, or adapted. A work consisting of editorial *revisions*, annotations, elaborations, or other modifications which,

(continued...)

have enjoyed with respect to only one component thereof, the Replica.

With respect to the Sequence and its unauthorized use of Greenberg's diver photograph, we find that the Society has infringed upon the photographer's exclusive right under § 106(2) to prepare derivative works based upon his copyrighted photograph. The Society has selected ten preexisting works, photographs included in covers of ten issues of the Magazine, including Greenberg's, and transformed them into a moving visual sequence that morphs one into the other over a span of approximately 25 seconds. Moreover, the Society repositioned Greenberg's photograph from a horizontal presentation of the diver into a vertical presentation of that diver. Manifestly, this Sequence, an animated, transforming selection and arrangement of preexisting copyrighted photographs constitutes at once a compilation, collective work, and, with reference to the Greenberg photograph, a derivative work. *See Warren Publ'g,* 115 F.3d at 1515 n. 16.

The Society argues that its use of Greenberg's diver photograph was a fair use under § 107.[15] Guided by the

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[14] (...continued)

> *as a whole*, represent an original work of authorship, is a "derivative work".

(Emphasis added). Note that in order to qualify as a derivative work, the resulting work (including "revisions") after transformation must qualify as an "original work of authorship." Thus, the mere electronic digital reproduction that represents the Replica may not qualify as a derivative work, and thus not violate Greenberg's exclusive right to prepare derivative works under § 106. *See* supra note 10. This derivative-works issue may be addressed by the Supreme Court in *Tasini v. New York Times Co.,* 972 F. Supp. 804 (S.D.N.Y.1997), *rev'd,* 206 F.3d 161 (2d Cir. 2000), *cert. granted,* 69 U.S.L.W. 3312, 3316 (U.S. Nov. 6, 2000) (No. 00-201). But here, as explained above, we have far more than a mere reproduction in another medium.

[15] Among the factors to be considered in determining whether a use of a copyrighted work is a "fair use" are:

(continued...)

principles explained in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164 (1994),[16] we find that the Society has neither a fair use defense or right. *See Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 n. 22 (11th Cir. 1996); David Nimmer, "An Odyssey through Copyright's Vicarious Defenses," 73 N.Y.U. L. Rev. 162, 191 (1998). The use of the diver photograph far transcended a mere reprinting or borrowing of the work. As explained above, it became an integral part of a larger, new collective work. The use to which the diver photograph was put was clearly a transformative use. The Sequence reflects the transformation of the photograph as it is faded into and out of the preceding and following photographs (after having turned the horizontal diver onto a vertical axis). The Sequence also integrates the visual presentation with an audio presentation consisting of copyrightable music. The resultant moving and morphing visual creation transcends a use that is fair within the context of § 107. Moreover, while the CNG is a product that may serve educational purposes, it is marketed to the public at book stores, specialty stores, and over the Internet. The Society is a non-profit organization, but its subsidiary National Geographic Enterprises, which markets and distributes the CNG, is not; the sale of the CNG is clearly for profit. Finally, the inclusion of

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[15] (...continued)

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
> (2) the nature of the copyrighted work;
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

[16] In *Campbell*, the Supreme Court indicated that the statutory factors in § 107 should not "be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright." 510 U.S. at 578, 114 S. Ct. at 1170-71.

Greenberg's diver photograph in the Sequence has effectively diminished, if not extinguished, any opportunity Greenberg might have had to license the photograph to other potential users.[17]

Alternatively, the Society contends that its use of Greenberg's diver photograph, which appeared on the cover of the January 1962 issue of the Magazine, constitutes a *de minimis* use and thus is not actionable. We find no merit in that argument in the context of this derivative and collective work, the Sequence.

In assessing a *de minimis* defense, we must examine both the *quality* and *quantity* of the use.[18] Greenberg's photograph is one of ten selected and arranged by the Society and constitutes one-tenth of the entire Sequence; a pro-rata share. Thus, when comparing the entire work with the contribution at issue, it clearly represents a significant portion of the new work. This is particularly accentuated in a qualitative way when we consider that only ten covers from a universe of some 1200 covers of the Magazine, embracing 108 years of publication, were selected for this composition. Moreover, the instruction materials that accompany the CD-ROM discs inside the CNG product box refer to the Sequence as "The Complete National Geographic *icon*" (emphasis added). *[R1- 20-Ex. A]*

Each and every time a user of the CNG views any of the 30 discs, the user views the Sequence-the projection of the Sequence is automatic without any prompting from the user.

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[17] The inclusion by the Society of Greenberg's photograph in a newly copyrighted work, the Sequence, clearly indicates that the Society claims certain copyright rights in the photograph, with which potential licensees or assignees of the photograph would have to be concerned.

[18] *See Horgan v. Macmillan, Inc.*, 789 F.2d 157, 162 (2d Cir. 1986) ("Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement."); *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287, 1300 (C.D. Cal. 1995) ("[T]he court must look to the quantitative and qualitative extent of the copying involved.").

Thus, the use of the Sequence in the context of the entire CNG is not a *de minimis* use that fails to reach the threshold of actionable copyright infringement. The two cases principally relied upon by the Society, *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70 (2d Cir. 1997), and *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F. Supp. 1044 (S.D.N.Y. 1994), are not to the contrary. The "iconic" display at the beginning of each disc in the CNG product argues against the suggestion that the use of the Sequence in the CNG or the use of the Greenberg diver photograph in the Sequence is inconsequential. Accordingly, because we find the unauthorized use of the subject photograph to be both qualitatively and quantitatively significant, we reject the *de minimis* defense advanced by the Society and its putative co-infringers.

III. CONCLUSION

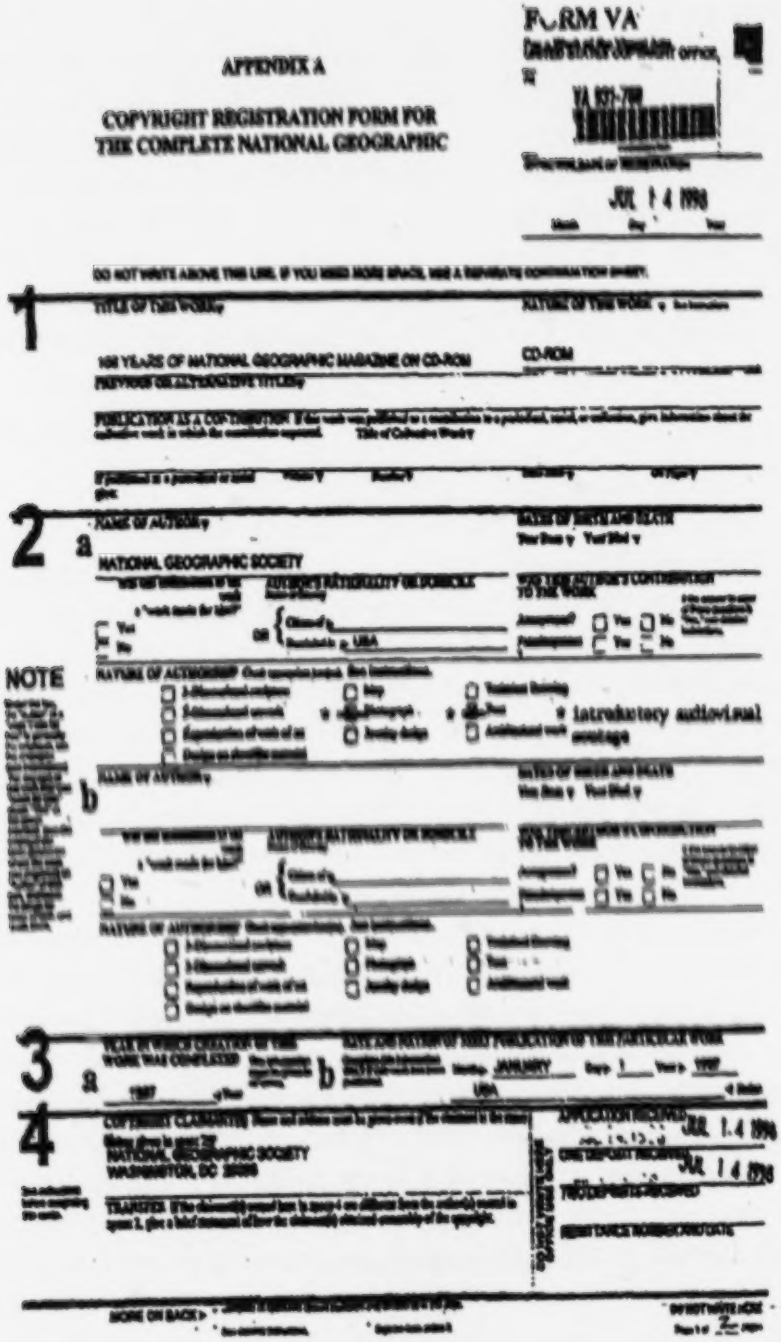
We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded the Society under § 201(c). We also find that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement, and that the proffered *de minimis* use defense is without merit. ~~Upon remand, the court below is directed to enter judgment on these copyright claims in favor of Greenberg. Counsel for the appellant should submit its documented claims for attorneys fees relative to this appeal to the district court for review and approval. We find the appellant to be the prevailing party on this appeal and, therefore, is entitled to an award of costs and attorneys fees.~~ Upon remand, the district court should ascertain the amount of damages and attorneys fees that are due, if any, as well as any injunctive relief that may be appropriate. In assessing the appropriateness of injunctive relief, we urge the court to consider alternatives, such as mandatory license fees,

in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.

REVERSED and **REMANDED.**

APPENDIX A

COPYRIGHT REGISTRATION FORM FOR
THE COMPLETE NATIONAL GEOGRAPHIC


FORM VA

VA 831-799

JUL 14 1998

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

1 TITLE OF THIS WORK ▼ NATURE OF THIS WORK ▼

100 YEARS OF NATIONAL GEOGRAPHIC MAGAZINE ON CD-ROM CD-ROM

PREVIOUS OR ALTERNATIVE TITLES ▼

PUBLICATION AS A CONTRIBUTION If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work ▼

If published in a periodical or serial give: Volume ▼ Number ▼ Issue Date ▼ On Pages ▼

2 a NAME OF AUTHOR ▼ DATES OF BIRTH AND DEATH Year Born ▼ Year Died ▼

NATIONAL GEOGRAPHIC SOCIETY

Was this contribution to the work a "work made for hire"? Yes / No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country OR Domiciled in ▼ USA

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK Anonymous? Yes / No Pseudonymous? Yes / No

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

3-Dimensional sculpture; Map; Technical drawing; 2-Dimensional artwork; Photograph; Text; Reproduction of work of art; Jewelry design; Architectural work; Design on useful article

NOTE: Under the law, the "author" of a "work made for hire" is generally the employer, not the employee (see instructions). For any part of this work that was "made for hire" check "Yes" in the space provided, give the employer (or other person for whom the work was prepared) as "Author" of that part, and leave the space for dates of birth and death blank.

Introductory audio/visual montage

b NAME OF AUTHOR ▼ DATES OF BIRTH AND DEATH Year Born ▼ Year Died ▼

Was this contribution to the work a "work made for hire"? Yes / No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country OR Domiciled in ▼

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK Anonymous? Yes / No Pseudonymous? Yes / No

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

3-Dimensional sculpture; Map; Technical drawing; 2-Dimensional artwork; Photograph; Text; Reproduction of work of art; Jewelry design; Architectural work; Design on useful article

3 a YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED 1997 Year ▼

b DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK Month JANUARY Day 1 Year 1997 USA Nation ▼

4 COPYRIGHT CLAIMANT(S) Name and address must be given even if the claimant is the same as the author given in space 2. ▼

NATIONAL GEOGRAPHIC SOCIETY
WASHINGTON, DC 20036

TRANSFER If the claimant(s) named here in space 4 are different from the author(s) named in space 2, give a brief statement of how the claimant(s) obtained ownership of the copyright. ▼

APPLICATION RECEIVED JUL 14 1998

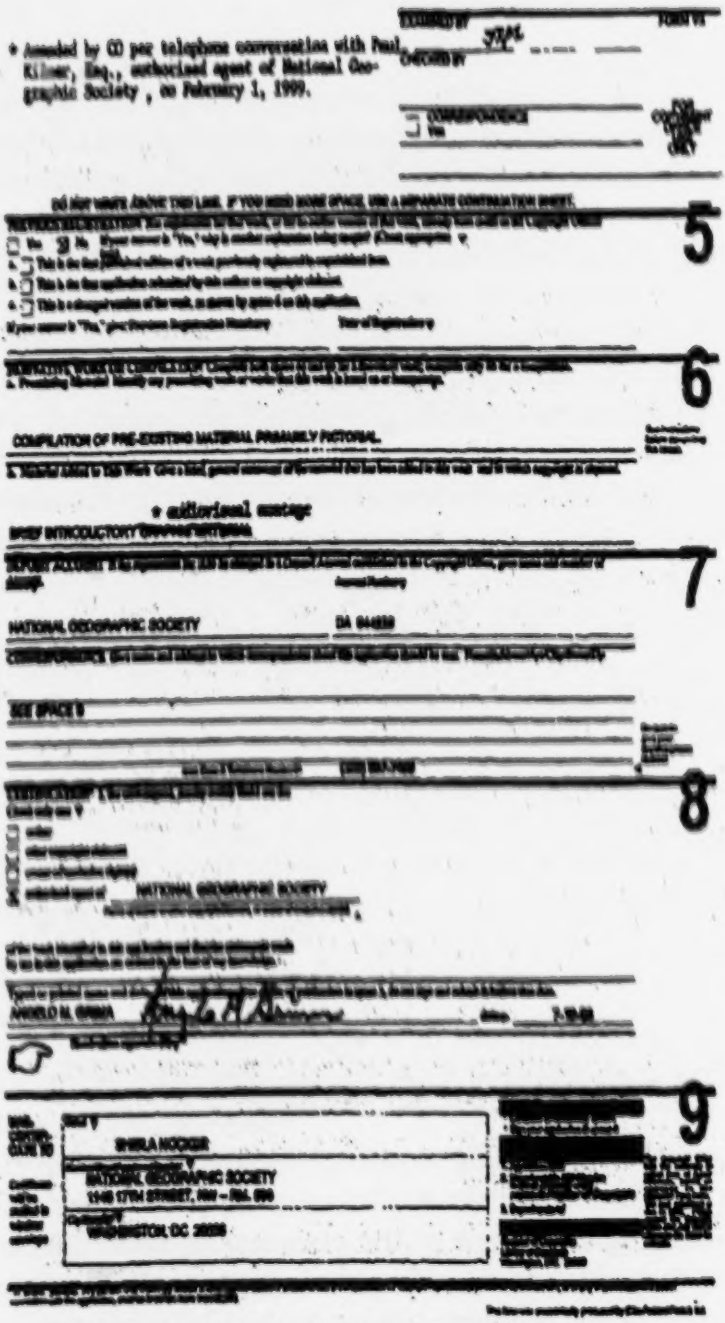
ONE DEPOSIT RECEIVED JUL 14 1998

TWO DEPOSITS RECEIVED

FUNDS RECEIVED

MORE ON BACK ▶ DO NOT WRITE ABOVE

BEST AVAILABLE COPY



* Amended by CO per telephone conversation with Paul Kilmer, Esq., authorized agent of National Geographic Society , on February 1, 1999.

5

6

COMPILATION OF PRE-EXISTING MATERIAL PRIMARILY PICTORIAL.

* additional matter

7

NATIONAL GEOGRAPHIC SOCIETY

SEE SPACE 9

8

NATIONAL GEOGRAPHIC SOCIETY

9

SHEILA HOCKER

NATIONAL GEOGRAPHIC SOCIETY
1145 17TH STREET, NW – RM. 000

WASHINGTON, DC 20036

APPENDIX B

EXCERPT FROM H.R. 94-1476 (1976) *reprinted in* 1976 U.S.C.C.A.N. 5659

Contributions to collective works

Subsection (c) of section 201 deals with the troublesome problem of ownership of copyright in contributions to collective works, and the relationship between copyright ownership in a contribution and in the collective work in which it appears. The first sentence establishes the basic principle that copyright in the individual contribution and copyright in the collective work as a whole are separate and distinct, and that the author of the contribution is, as in every other case, the first owner of copyright in it. Under the definitions in section 101, a "collective work" is a species of "compilation" and, by its nature, must involve the selection, assembly, and arrangement of "a number of contributions." Examples of "collective works" would ordinarily include periodical issues, anthologies, symposia, and collections of the discrete writings of the same authors, but not cases, such as a composition consisting of words and music, a work published with illustrations or front matter, or three one-act plays, where relatively few separate elements have been brought together. Unlike the contents of other types of "compilations," each of the contributions incorporated in a "collective work" must itself constitute a "separate and independent" work, therefore ruling out compilations of information or other uncopyrightable material and works published with editorial revisions or annotations. Moreover, as noted above, there is a basic distinction between a "joint work," where the separate elements merge into a unified whole, and a "collective work," where they remain unintegrated and disparate.

The bill does nothing to change the rights of the owner of copyright in a collective work under the present law. These exclusive rights extend to the elements of compilation and editing that went into the collective work as a whole, as well as the contributions that were written for hire by employees of the

owner of the collective work, and those copyrighted contributions that have been transferred in writing to the owner by their authors. However, one of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions.

The second sentence of section 201(c), in conjunction with the provisions of section 404 dealing with copyright notice, will preserve the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work. This is coupled with a presumption that, unless there has been an express transfer of more, the owner of the collective work acquires "only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series."

The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution publisher could not revise the contribution itself or include it in a new anthology or an entirely different itself or include it in a new anthology or an entirely different magazine or other collective work.

APPENDIX B

June 8, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ON PETITION(S) FOR REHEARING AND
PETITION(S) FOR REHEARING EN BANC
(Opinion _____, 11th Cir., 19___, ____F.2d____).

Before: ANDERSON, Chief Judge, TJOFLAT and BIRCH, Circuit Judges.

Per Curiam

The Petition(s) for Rehearing are DENIED and no member of this panel nor other Judge in regular active service on the

Court having requested that the Court be polled on rehearing en banc (Rule 35, Federal Rules of Appellate Procedure; Eleventh Circuit Rule 35-5), the Petition(s) for Rehearing En Banc are DENIED.

ENTERED FOR THE COURT

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX C

April 20, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ORDER

The motion by amici curiae Magazine Publishers of America, *et. al.*, for leave to file a petition for rehearing en banc is DENIED.

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX D

KIRKLAND & ELLIS
PARTNERSHIPS INCLUDING PROFESSIONAL CORPORATIONS

655 Fifteenth Street N.W.
Washington, D.C. 20005

(202) 879-5000 Facsimile: 202 879-5200

Kenneth W. Starr
To Call Writer Directly:
(202) 879-5130
kenneth_starr@dc.kirkland.com

May 2, 2001

VIA MESSENGER

Mr. Thomas K. Kahn
Clerk of Court
United States Court of Appeals
for the Eleventh Circuit
56 Forsyth Street, N.W.
Atlanta, GA 30303

Re: *Greenberg v. National Geographic Society, et al.*,
Docket No. 00-10510
Amendment to Petition for Rehearing *En Banc*

Dear Mr. Kahn:

We received on Monday, April 30, the "corrected opinion" in the above-captioned case. Because this corrected opinion addresses one of the questions raised in our petition for rehearing (Question Number 3 concerning the award of attorneys' fees) and the error concerning entry of judgment for the plaintiffs pointed out at page 14, footnote 3, of the petition, we wish to notify the entire *en banc* court that we respectfully withdraw Question Number 3 (pp. 13-14) and that portion of

the brief concerning entry of judgment for the plaintiffs (p. 14, note 3).

In addition to the merits of our petition relating to Section 201(c) of the Copyright Act (addressed in Question 1 of our petition), the corrected opinion fails to correct the accusation of "fraud" on the Copyright Office by National Geographic at footnote 13 of the opinion, which is addressed in Question 2 of our petition. We have today received a letter from the General Counsel of the Copyright Office of the United States, David Carson, bearing directly on the appropriateness of the registration filed by the National Geographic Society in the application process with the Copyright Office.

We respectfully request that you provide this letter to all of the active judges considering the petition and the attached letter from the Copyright Office of the United States.

Respectfully submitted,

/s/

Kenneth W. Starr

cc: Norman Davis, Esq.

LIBRARY OF CONGRESS
COPYRIGHT OFFICE
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000

May 2, 2001

Terrence B. Adamson
Executive Vice President
The National Geographic Society
1145 17th Street, NW
Washington, DC 20036-4688

Re: Greenberg v. National Geographic Society

Dear Mr. Adamson:

We are writing in response to your letter of April 5, 2001, relating to the decision of the United States Court of Appeals for the Eleventh Circuit in *Greenberg v. National Geographic Society*, No. 00-10510.

Although the Copyright Office does not often comment on the merits of private civil litigation, the court's remarks about the National Geographic Society's possible fraud on the Copyright Office appear to reveal a misunderstanding of Copyright Office registration practices. In the rare cases in which appellate courts discuss our registration practices in a way that is likely to confuse the public, we will speak out in the interests of justice, public education and the orderly administration of the copyright laws. See the Office's Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000), and *Raquel v. Education Management Corp.*, 121 S. Ct. 376 (2000) (granting writ of certiorari, vacating the decision of the court of appeals, and remanding "for further consideration in light of

the position asserted by the Solicitor General in his brief for the United States, as *amicus curiae*, filed September 20, 2000, and the Copyright Office's July 5, 2000, Statement of Policy, 65 Fed. Reg. 41,508").

In this case, we are pleased to set the record straight and confirm that having reviewed certificate of registration no. VA 931-760 as well as the registered work, "108 Years of National Geographic Magazine CD-ROM," we find that the National Geographic Society's application complied with the Office's requirements for registration, and that there is no reason to conclude that the application misled the Office in any way. To the extent that your letter invites the Office to express its views on the merits in general of the Eleventh Circuit's opinion in *Greenberg*, we must decline the invitation. Although the Office has misgivings about the *Greenberg* opinion in a number of respects, we do not believe that this is the appropriate occasion to express our views, apart from explaining how the court misunderstood the Office's registration practices.

The statement in *Greenberg* that has caused concern in the Office appears in a footnote:

> As noted earlier, the Society failed to indicate the third, and critical, element of the new work, the Program. While the storage and retrieval system may be "transparent" to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user. *Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office.*

Slip opinion at 14, n. 13 (emphasis added). This statement casts doubt on the National Geographic Society's conduct in

connection with its application to register "108 Years of National Geographic Magazine CD-ROM," and on a standard practice in registration of copyrights in works on media such as CD-ROMs.

The court of appeals appears to have erroneously concluded that certificate of registration No. VA 931-760 purports to be a registration of the entire contents of the CD-ROM series constituting "108 Years of National Geographic Magazine CD-ROM."* Our review leads us to a very different conclusion: the certificate purports to register the copyright only in what is described on the face of the certificate as "brief introductory audiovisual montage." It is apparent that this is a reference to what the *Greenberg* opinion refers to as the "moving covers sequence," or simply the "Sequence." See slip op. at 4.

To understand what copyrighted material is being registered, one must carefully examine the application for registration. Although space 1 of the application states that the title of the work is 108 Years of National Geographic Magazine on CD-ROM," space 2 describes the "nature of authorship" as "introductory audiovisual montage." As the *Compendium of Copyright Office Practices, Compendium II* states, "In general, the nature of authorship defines the scope of the registration; therefore, it represents an important copyright fact." *Compendium II*, §619 (1988); see also Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000). Thus, the entry in space 2 clarifies that what is being registered is that introductory sequence, rather than the entire contents of the CD-ROMs on which the sequence appears.

Moreover, the entries in space 6 further clarify that the only subject matter being registered is the introductory sequence. Space 6 of an application for copyright registration seeks

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* The application for registration is reproduced in its entirety as part of the certificate of registration.

information about compilations and derivative works. Space 6 of certificate of registration No. VA 931-760 clearly identifies the work being registered as a derivative work, stating in space 6a that the preexisting material includes a "compilation of pre-existing material primarily pictorial," and stating in space 6b that the "material that has been added to this work and in which copyright is claimed" consists of a "brief introductory audiovisual montage."** The court's conclusion that the certificate of registration reveals that "the registered work, the CNG, was a compilation," slip op. at 14, is thus based on a misinterpretation of the certificate. While the certificate states that the preexisting material was a compilation, it does not state that the additional material, the "audiovisual montage," was a compilation. Of course, it is possible to view that audiovisual montage as a compilation—but that compilation would simply be a compilation of covers from past issues of the National Geographic magazine, not a compilation of, in the words of the court, "the Sequence, the Replica, and the Program." See slip op. at 13.

Hence, the National Geographic Society's application for copyright registration clearly sought registration only of the copyright in the introductory sequence. The Office clearly understood this and issued the certificate of registration based on that understanding.***

** See Copyright Office Circular 55, *Copyright Registration for Multimedia Works*, at 4 ("**New Material Added (6b)**. Briefly describe all the new copyrightable authorship that is the basis of the present registration. An example is: 'some new text, new photography.' (The statement used in 6b may be used in space 2 to describe the author's contribution.)").

*** The certificate indicates that the information in spaces 2 and 6a was amended by a Copyright Office examiner as a result of a telephone conversation with an attorney representing the National Geographic Society. This is a common practice when the examiner believes that clarification of

(continued...)

Accordingly, there can be no question of any attempt to perpetrate a fraud on the Copyright Office, and the court's speculation in footnote 13 of the opinion is inconsistent with the Copyright Office registration record for this particular work.

There is another reason why the court's reference to possible fraud on the Copyright Office is inconsistent with the Office's actual examination and registration practices. A trained examiner understands that a straight, chronological replication of 108 years' worth of National Geographic Magazine does not rise to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, coordination or arrangement. However, assuming that the National Geographic Society had attempted to register a copyright in the entire compilation of 108 years of issues of the National Geographic magazine on CD-ROM, the court appears to have implied that the Society may have attempted to conceal from the Office the presence of the software that is included on the CD-ROM to enable users to gain access to the contents of the magazine issues, and that this possible concealment may have been intended to avoid the consequences that would have ensued if the Office had been

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*** (...continued)
the copyright claim is needed. The original application included a claim in "photograph" and "text," but following the telephone conversation, those claims were deleted, apparently because the examiner explained to the attorney that the photographs and text in question were part of a straight, chronological replication of 108 years' worth of issues of National Geographic Magazine, which a trained examiner would understand as not rising to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, organization or arrangement. The attorney authorized the examiner to delete the references to "photograph" and "text," and to insert the references to "introductory audiovisual montage." Thus, the application in its final form claimed copyright only in a very limited portion of the content on the CD-ROM, and the Office was aware of this.

aware of the presence of the software on the CD-ROM. We infer this because of the court's reference to "fraud on the Copyright Office." The doctrine of fraud on the Copyright Office provides that the knowing submission of a misleading application for copyright registration may invalidate the resulting registration if awareness of the true facts might have caused the Copyright Office to deny registration. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989); *S.O.S., Inc. v Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989); 2 M. & D. Nimmer, *Nimmer on Copyright* § 7.20[B], at 7-209 (2000).

If this is what the court was thinking, the court misunderstood another aspect of copyright registration practice. The Copyright Office recognizes that when works of authorship embodied in CD-ROM format are submitted for registration, computer programs may be included on the same CD-ROM, and that use of those computer programs may be necessary in order for a user to gain access to the work of authorship in which copyright is claimed. However, it is not necessary in such cases that the application for copyright registration include a claim of copyright in the software.

The Copyright Office Examining Division examines works of authorship embodied in CD-ROM format also according to its "Interim CD-ROM Practices, Literary Section, Rev. 2/95."**** The Practices acknowledge that a single CD-ROM disc may contain "many different types of material, including text, still images: photographs and illustrations, artwork, maps, sounds . . ., motion pictures . . ., computer software code . . ." and that "computer program text is only one of the elements that can be stored on a CD-ROM disc." CD-ROM Practices at 1. The Practices further state that "the author of the material on

---

**** Although the Practices are titled "Literary Section," they apply to registration claims received in all classes of authorship and are used by all examiner staff within the Division.

the CD-ROM can also be the author of the retrieval software. Sometimes, however, a company will put together the material on the CD-ROM but use preexisting operating software which may or may not belong to that same company." CD-ROM Practices at 2.

Under these practices, an examiner will accept an application for registration in which no claim is specifically made for the retrieval software embodied in the CD-ROM as long as there is no information elsewhere on the application or on the deposit copy of the CD-ROM itself which indicates that the software may be owned by the same party claiming copyright in the substantive content of the CD-ROM. This is consistent with the Division's CD-ROM Practices noted above, which explicitly recognize that the copyright owner of some or all of the substantive content fixed in the CD-ROM may not be the same party that owns the copyright in the retrieval software present on the CD-ROM. Further, an examiner will also accept an application for registration in which no claim is specifically made for the software even if it is factually the case that the same party does own both the substantive content *and* the retrieval software embodied in the CD-ROM. The reason for the latter is that as long as the claim is facially acceptable, *i.e.*, all registration requirements for the authorship explicitly claimed have been met, the examiner will not investigate further and will not communicate with the applicant, according to the general examining principles in *Compendium II*, to determine whether the applicant wishes to extend the scope of the claim. In other words, if the applicant is entitled to claim copyright in the software but elects not to assert that claim, the Examining Division will not require the applicant to make the claim. The Examining Division assumes that the applicant has accurately described the extent of the authorship for which registration is sought. Moreover, if the applicant subsequently finds that the description of the extent of the authorship is incorrect and that additional authorship should have been

claimed, a supplementary registration may be made under 37 C.F.R. 201.5.

Thus, after review of the registration in question by appropriate supervisory examiner staff, the Office considers the registration no. VA 931-760 for the "introductory audiovisual montage" in the work "108 Years of National Geographic Magazine on Cd-ROM" to be valid because the registration was made within required examining guidelines. The National Geographic Society had no obligation to disclose or assert a copyright claim in the software.

The Copyright Office provides information to the public about its examining and registration practices in a series of circulars, including Circular 55, *Copyright Registration for Multimedia Works*. Circular 55 explains that although "All copyrightable elements of a multimedia kit may generally be registered with a single application, deposit and fee . . . [s]eparate registrations for individual elements may be made by submitting a separate application and filing fee each." Circular 55, at 2. Of particular significance with respect to registration no. VA 931-760, the Circular also states:

> "A separate registration is required, however, for any element of a multimedia kit that is published separately or claimed by someone other than the copyright claimant for the other elements."

Circular 55, at 2. According to the opinion in *Greenberg*, the software that was included on the CD-ROM was created not by the National Geographic Society, but by Mindscape, Inc. Slip op. at 5. Moreover, the court appears to have concluded that Mindscape owns the copyright in the software. Slip op. at 6 n.3. If that is the case, the National Geographic Society could not have claimed copyright in the software, whether as part of the application for registration of "108 Years of National Geographic Magazine CD-ROM" or separately.

We understand that the court of appeals viewed the entire CD-ROM as a compilation, and that the elements of that compilation included (1) the "Sequence," (2) the digitally reproduced issues of the magazine themselves, and (3) the software that enables users to gain access to the contents of the magazine issues. However, although this letter will not express a view on the merits of that analysis and its implications with respect to what a publisher may do pursuant to 17 U.S.C. § 201(c), we can clarify that the Office's examining practices do not require the owner of the copyright in content that is included on a CD-ROM, and which can be accessed only by using software that is also included on the CD-ROM, to claim compilation authorship with respect to all of the contents (including the software) on the CD-ROM.

In conclusion, based on the facts as we understand them, we believe that the suggestion by the court of appeals that the National Geographic Society may have "perpetrated a fraud on the Copyright Office" when it submitted its application for registration no. VA 931-760 is based on a misunderstanding of copyright registration practices.

We hope that this letter assists in clarifying that the National Geographic Society's application as amended was consistent with Copyright Office policies and practices.

Sincerely,

/s/

David O. Carson
General Counsel

cc: Norman Davis, Esq.

APPENDIX E

May 16, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ORDER

Appellant's motion to strike the "Amendment to Petition for Rehearing" filed on May 3, 2001, by Appellee National Geographic Society, is GRANTED.

Appellant's motion for permission to respond to Appellees' rehearing petition, as amended, is DENIED, as moot.

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX F

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 97-3924-CIV-LENARD

JERRY GREENBERG, individually
IDAZ GREENBERG, individually,

Plaintiffs,

vs.

NATIONAL GEOGRAPHIC SOCIETY, a District of Columbia corporation, NATIONAL GEOGRAPHIC ENTERPRISES, INC., a corporation, and MINDSCAPE, INC., a California corporation,

Defendants.

ORDER GRANTING IN PART AND DENYING IN PART DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT

FILED MAY 14, 1998

THIS CAUSE comes before this Court upon Defendants' motion to dismiss and/or for summary judgment (D.E. 18), Plaintiff's cross-motion for summary judgment (D.E. 26), Plaintiff's motion for voluntary dismissal (D.E. 24), and Defendants' motion for oral argument (D.E. 28).

In 1990, Jerry Greenberg (Greenberg) provided National Geographic Society (Society) with a photograph he had taken

of a sea fan, for publication in the July 1990 issue of Society's magazine. Without Greenberg's permission, in 1996 Society reprinted the photograph in a promotional brochure. In 1995 and 1996, also without Greenberg's authorization, Society supplied other photographs taken by Greenberg, including those of a redband parrotfish, a spotlight parrotfish, and a green moray, to Educational Insights, Inc. (Insights), which used them in one of its products.

In 1997, Society, through National Geographic Enterprises, Inc. (Enterprises) and Mindscape, Inc. (Mindscape), produced and began to sell a 30 disc CD-ROM set, entitled The Complete National Geographic, which contains every issue ever published of Society's magazine. A number of the magazines published by Society over the years apparently contain photographs taken by Greenberg. At the beginning of each of the 30 discs in the CD-ROM set is an introduction to The National Geographic which consists of a sequence of ten of the magazine's covers. On one of those covers, from the magazine's January 1962 issue, is a photograph, taken by Greenberg, of a woman scuba diving around a coral reef.

On December 5, 1997, Plaintiff Greenberg filed an action in this Court for copyright infringement against Society, Enterprises and Mindscape. Greenberg alleges that Society infringed his copyright by providing his photographs of a redband parrotfish, a spotlight parrotfish and a green moray to Insights for use in its products (count I), and by reprinting his photograph of a sea fan in a 1996 promotional brochure (count II). Greenberg also alleges that Society, Enterprises and Mindscape infringed his copyright by reproducing a number of his photographs in The Complete National Geographic. On January 30, 1998, Defendants filed a motion to dismiss counts II through V of Greenberg's complaint and, in the alternative, a motion for summary judgment on counts III through V. As Greenberg and Defendants have supplemented their pleadings

with evidence, the Court will treat both of these motions as requests for summary judgment.

A motion for summary judgment may be granted only if no genuine dispute exists as to any material fact. Fed. R. Civ. P. 56(c). In deciding whether there is a genuine issue of material fact, the Court must view the pleadings, affidavits and other evidence in the record "in the light most favorable to the non-moving party." *Retina Associates, P.A. v. Southern Baptist Hosp. of Florida, Inc.*, 105 F.3d 1376, 1380 (11th Cir. 1997).

Defendants first contend that counts II through V of Greenberg's complaint must be dismissed, pursuant to 17 U.S.C. § 411(a), because there is no evidence that he registered his copyright in the photograph of the sea fan which Society printed in its 1996 promotional brochure, or in any of the photographs published in Society's magazines, including that of a woman scuba diving around a coral reef. Indeed, "copyright registration is a pre-requisite to the institution of a copyright infringement lawsuit." *Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc.*, 29 F.3d 1529, 1532 (11th Cir. 1994). Greenberg has provided the Court with evidence, however, that on December 18, 1995 Society assigned to him the copyrights in these photographs, and that he subsequently renewed those copyrights prior to the time of their expiration. Exhibit B, 1-3, Plaintiff's Memorandum in Opposition to Defendants' Motion to Dismiss or for Summary Judgment.

Defendants next argue, pursuant to 17 U.S.C. § 201(c), that counts III through V of Greenberg's complaint must be dismissed because Defendants are permitted to reproduce and distribute, in The Complete National Geographic, photographs taken by Greenberg, including his photograph of a woman scuba diving around a coral reef, which were previously published in Society's magazines.

Under 17 U.S.C. § 201(c):

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as a part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c). Defendants concede that the previous issues of Society's magazines in which Greenberg's photographs were published are collective works in which Defendants were permitted to reproduce Greenberg's photographs. They submit, however, that The Complete National Geographic constitutes a 'revision' of that collective work within the meaning of 17 U.S.C. § 201(c). Greenberg disagrees.

The Court has only been able to locate one published opinion, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), in which a court has addressed the issue whether a collective work is a revision within the meaning of this statute. In that case, a number of freelance writers whose articles were published in several widely read periodicals sued those periodicals and two companies to which the periodicals sold the writers' articles, one of which provided its subscribers with the texts of the articles electronically and the other of which distributed the texts on CD-ROM, for copyright infringement. The defendants argued that the electronic databases and the CD-ROM's promulgating the writers' articles were 'revisions' of the periodicals, collective works, within the meaning of 17 U.S.C. § 201(c).

The court observed that:

> If defendants change the original selection and arrangement of their newspapers or magazines, however, they are at risk of creating new works, works no longer recognizable as versions of the periodicals that are the source of their rights. Thus, in whatever ways they change their collective works, defendants must preserve some significant original aspect of those works—whether an original selection or an original arrangement—if they expect to satisfy the requirements of Section 201(c). Indeed, it is only if such a distinguishing original characteristic remains that the resulting creation can fairly be termed a revision of "that collective work" which preceded it.

Tasini, 972 F. Supp. at 821. In order to determine whether the electronic databases and CD-ROMs constituted a 'revision' of the periodicals, the court explained that a two-pronged inquiry is necessary. First, a court must identify any original selection or arrangement of materials in the collective work. Second, if the court concludes that the collective work possesses any such original selection or arrangement of materials, it must determine whether these characteristics are preserved electronically. *Tasini*, 972 F. Supp. at 821. The *Tasini* court then concluded that:

> If the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions of the publisher defendants' collective works. If, on the other hand, the electronic defendants do not preserve the originality of the disputed publications, but merely exploit the component parts of those

> works, then plaintiffs' rights in those component parts have been infringed.

Tasini, 972 F. Supp. at 822. This Court finds the *Tasini* Court's reasoning sound and therefore adopts the legal framework developed by that court to analyze the legal question currently before this Court.

Society indisputably selected and arranged the articles and photographs in each issue of its magazines. The question therefore arises whether this original selection and arrangement is preserved in The Complete National Geographic. In order to answer this question in the affirmative, the *Tasini* court noted that the electronic work "cannot differ in selection by more than a trivial degree from the work that preceded it." *Tasini*, 972 F. Supp. at 823.

As evidence that The Complete National Geographic does not differ by more than a trivial degree from Society's magazines, Defendants have supplied the Court with the declarations of Thomas Stanton, Society's Director of CD-ROM Product Management, who states that: (1) The Complete National Geographic contains an "exact image of each page as it appeared in the Magazine;" (2) The Complete National Geographic draws from the northeastern edition of Society's magazine; (3) the 30 to 40 regional editions of the magazine which Society publishes are identical except for the advertisements; and (4) at the beginning of each CD-ROM in The Complete National Geographic, there is a short display of images from ten different magazine covers, including the January 1962 cover showing the picture taken by Greenberg of a woman scuba diving around a coral reef. Declaration of Thomas Stanton, P 5-7; Reply Declaration of Thomas Stanton, P 4. Greenberg has not adduced any evidence to contradict Stanton's statements.

He submits, however, that the image display and Society logo at the beginning of each disc, the credit display at the end

of each disc, and Society's selection of one edition of the many editions of the magazine, render The Complete National Geographic more than trivially different from Society's magazines. This Court disagrees, and concludes that the evidence produced by Defendants indicates that the Complete National Geographic "retain[s] enough of Defendants' periodicals to be recognizable as versions of those periodicals." *Tasini*, 972 F. Supp. at 824. Consequently, The Complete National Geographic constitutes a 'revision' of Society's magazines within the meaning of 17 U.S.C. § 201(c). Defendants therefore did not improperly reproduce or distribute, in The Complete National Geographic, Greenberg's photographs.

Accordingly, it is hereby ORDERED AND ADJUDGED that:

(1) Defendants' motion to dismiss and/or for summary judgment as to count II, be DENIED;

(2) Defendants' motion for summary judgment as to counts III, IV and V, be GRANTED. Counts III, IV and V are therefore DISMISSED with prejudice.*

(3) Plaintiff Greenberg's cross-motion for summary judgment as to count III, be DENIED;

(4) Plaintiff Greenberg's motion to voluntarily dismiss count IV, be DENIED as MOOT; and

(5) Defendants' request for oral argument, be DENIED.

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* Defendants also contend that counts III through V should be dismissed because their use in the image display at the beginning of each disc of The Complete National Geographic of Greenberg's 1962 cover photograph of a woman scuba diving around a coral reef is: (1) de minimis; and (2) fair use within the meaning of 17 U.S.C. § 107. In light of its conclusion that Defendants are permitted to use the cover photograph at issue pursuant to 17 U.S.C. § 201(c), the Court need not entertain these arguments.

DONE AND ORDERED in Chambers, at Miami, Florida on this 14 day of May, 1998.

/s/
Joan A. Lenard
United States District Judge

Supreme Court, U.S.
FILED
AUG 30 2001
CLERK

No. 01-186

IN THE

Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.
and MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG and IDAZ GREENBERG,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF IN OPPOSITION

NORMAN DAVIS
Counsel of Record
STEEL HECTOR & DAVIS LLP
Attorneys for Respondents
4000 First Union Financial Center
200 South Biscayne Boulevard
Miami, Florida 33131-2398
(305) 577-2988

169129

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTIONS PRESENTED

1. **WHETHER THE ELEVENTH CIRCUIT'S OPINION CONFLICTS WITH THIS COURT'S RECENT DECISION IN *NEW YORK TIMES CO. v. TASINI.***

2. **WHETHER THE COURT BELOW CORRECTLY HELD THAT THE COMPLETE NATIONAL GEOGRAPHIC ("CNG") QUALIFIES AS A NEW COLLECTIVE WORK THAT IS NOT PROTECTED BY THE PRESUMPTIVE PRIVILEGE IN SECTION 201(c) OF THE COPYRIGHT ACT.**

3. **WHETHER FOOTNOTE 13 IN THE ELEVENTH CIRCUIT'S OPINION HAS ANY RELEVANCE TO THE HOLDING IN THE CASE DECIDED BELOW THAT WARRANTS REVIEW.**

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Other Authority:

H.R. Rep. No. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 ..... 5, 15

STATEMENT OF THE CASE

Respondents do not adopt the Statement of the Case submitted by Petitioners. Respondents do adopt, for purposes of this brief in opposition, the "Background" portion of the opinion prepared by the Eleventh Circuit, with exceptions noted below. *See* 244 F.3d at 1268-71. That opinion is attached to the petition as Appendix A.

The CD-ROM product that is the focus of the litigation is in the record below. In their argument, Respondents refer to the product — "108 Years of the Complete National Geographic" — as the "CNG."

The Eleventh Circuit identified the component elements of the CNG as: (a) the "Replica," consisting of reprints of the 1200-plus monthly magazines themselves, (b) the "Sequence," consisting of the electronic morphing of ten covers from selected issues of the monthly magazine that appears when each disc is opened, and (c) the "Program," which permits the CD-ROM discs to display graphic and aural materials and which performs other functions. That depiction of the CNG's components was factually adequate for the conclusions drawn by the court. But the CNG contains other materials and other capabilities that even more forcefully support the Eleventh Circuit's holding of infringement, including the following:

- An animated globe logo with music
- A National Geographic Interactive visual montage with sound
- A Kodak advertisement with voice and music

- An electronically-morphed sequence of magazine covers with music
- Word-search capability
- Advanced search capability using Boolean operators, wildcards, truncated words
- Feature for saving search results
- Article-by-article inspection
- An interactive link with the NGS web site
- A bookmark feature
- A button for printing any page displayed on screen

Each of those elements and capabilities is readily visible to, or available to, an end user of the CNG. Petitioners' assertion (Pet. at 5) that the CNG "does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way," is not correct. The product's program does not provide that means, but the universal file format codes utilized in the product provide an easy means for an end user to open, edit and copy particular pages for manipulation.[1]

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1. Similarly, the Eleventh Circuit's observation that "the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way" is not correct. 244 F.3d at 1269.

The Petitioners' discussion of microfilm and microfiche, and particularly of the characteristics and capabilities of such microform reproduction, is supported by no record evidence of any kind.

The letter from the U.S. Copyright Office that is included in Appendix D to the petition did not appear spontaneously but was solicited, as the letter itself indicates, through an inquiry from the National Geographic Society. The letter was stricken by the Eleventh Circuit on motion by the Respondents, and is not in the record below.

The copyright registration attached to the Eleventh Circuit's opinion as Appendix A, *see* 244 F.3d 1267 (11th Cir. 2001), identifies the title of the work to be registered as "108 Years of National Geographic Magazine on CD-ROM," identifies 1997 as the year of completion of the work (the most recent monthly magazine included in the CNG was from 1996), and indicates that the work being registered, and any earlier version of the work, had not been registered before.

REASONS FOR DENYING THE WRIT

Introduction

The Court should deny the writ because: (1) there is no conflict with any decision by this Court or any other, and (2) the Eleventh Circuit correctly ruled on the facts and the law before it.

In their zeal to gain entry to the Court, the Petitioners rely almost totally on what they assert to be a conflict between *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001), and *New York Times Co. v.*

Tasini, 121 S. Ct. 2381 (2001). In the process, as will be apparent below, they distort this Court's holdings and discussion in *Tasini* beyond recognition. The very notion of "conflict" between the two decisions is meaningless because the Petitioners are misreading, and omitting, what the Court said in *Tasini*.

Moreover, the facts in the two cases were strikingly different. Both courts ultimately concluded that the publishers had failed to satisfy any of the requirements contained in Section 201(c) of the Copyright Act, 17 U.S.C. § 201(c), for application of the presumptive privilege set forth in that section. Both courts affirmed authors' *rights* to a continued interest in their copyrighted works, subject only to the limited and presumed *privilege* for publishers in Section 201(c). That section says that a publisher of a collective work, such as a magazine,

> is presumed to have acquired only the privilege of reproducing and distributing the [author's] contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c). Both courts relied on the same House Committee Report that in 1976 explained the decade-long evolution of the presumptive privilege in Section 201(c):

> [A] publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution

> itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. No. 94-1476 at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 [hereinafter "House Report"]. The House Report is quoted and relied on in *Tasini*, 121 S. Ct. at 2389, and in *Greenberg*, 244 F.3d at 1273.[2]

This brief will demonstrate that the holdings of *Tasini* and *Greenberg* are consistent, the "conflicts" that Petitioners point to are chimerical, and that *Greenberg* was properly decided.

I. THE PETITIONERS' ATTEMPTS TO CHARACTERIZE *GREENBERG* AS IN "CONFLICT" WITH *TASINI* FAIL BECAUSE THE OUTCOMES IN THE CASES ARE CONSISTENT

A. The Context Discussion

The Petitioners focus on the *Tasini* Court's discussion of "context" in relation to Section 201(c). In the Petitioners' view, "[a]s long as each individual contribution remains in its 'original context,' the publisher has not infringed the author's copyright." Pet. at 2. The Eleventh Circuit, they contend, was in error in finding infringement because

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2. Notwithstanding that both courts cited to the legislative history, the Petitioners attempt to downplay its role here. Courts have no authority, says their brief, to enforce a principle gleaned solely from legislative history that has no statutory reference point. (Pet. at 14.) But the link between the House Report and Section 201(c) could not be more obvious, and both courts acknowledged that linkage.

the Greenberg photographs remain in context in the CNG. Very much to the contrary, the court below held that the CNG was far removed from the context in which the Greenberg photographs first appeared, because: (a) the photographs now appear in a new collective work — the CNG — forbidden under Section 201(c), and (b) because the photographs did not appear in a context contemplated in the statute. The "context" issue is thus no issue at all.

The Court's opinion clearly explains its reference to "context" when the word is first used there:

> [T]he three Databases present articles to users clear of the context provided either by the *original periodical editions* or by any *revision of those editions*. . . . We cannot see how [any of the databases] perceptibly reproduces and distributes the article "as part of" either the original edition or a "revision" of that edition.

121 S. Ct. at 2390-91 (emphasis added).

The Court's use of "context" in its discussion thus relates directly to the exact words used in Section 201(c). A publisher intending to rely on the privilege stated there must heed the literal re-publishing context specified in that section.

As described more fully below, the Eleventh Circuit held that the CNG is *not within the context of any of the permissible reproductions* in Section 201(c). The legislative language in the House Report amplifies what the phrases in that section mean, and provides both permitted and prohibited examples. Congress said that a publisher could reprint a contribution from one issue in a later issue of its magazine

("the same series"),[3] or reprint the contribution intact from an earlier edition in a later edition of an encyclopedia. The publisher could not revise the contribution itself, or include it in a new anthology or an entirely different magazine or other collective work.

The *Tasini* Court similarly concluded, in a vital passage completely ignored by the Petitioners:

> It would scarcely "preserve the author's copyright in a contribution" as contemplated by Congress, if a . . . magazine publisher were permitted to reproduce or distribute copies of the author's contribution *in isolation* or within *new collective works*.

121 S. Ct. at 2389 (citations omitted) (emphasis added). Thus the Court said that the context requirement of Section 201(c) can be violated in two ways. One is by lifting a contribution out of the context in which it first appeared to an end user, and placing it in isolation. In *Tasini*, that involved the immersion of individual articles in isolation in vast databases. A violation also can occur, under the Court's proscription, by placing the contribution in a new collective work. Such a work would not fit within any of the permitted uses, or contexts, in Section 201(c). Not surprisingly, Petitioners embrace the first prohibition stated by the Court, and casually brush aside the second.

With respect to this Court's admonition quoted above, a magazine publisher cannot reproduce or distribute copies of

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3. To illustrate, a copyrighted photograph by Jerry Greenberg that appeared in the January 1962 issue of the Society's magazine was lawfully reprinted in the July 1990 issue of the magazine.

the author's contribution *in isolation* or within *new collective works*. *Tasini* involved issues of isolation; *Greenberg* involved a new collective work. Both violated Section 201(c). The issues were different, but the outcomes are not in conflict.

Petitioners, straining to circumvent the express prohibition against inclusion of the Greenberg photographs in a new collective work, attempt to create an exception to the prohibition where the author's contribution, and the original collective work in which it first appeared, are incorporated in a new collective work. (Pet. at 16). However, Petitioners do not and cannot point to any language — statutory, Congressional, or in case law — carving out such an exception. Similarly, there is no exception to the express prohibition involving new collective works merely because an author's contribution remains in the "context" in which it was originally published. This Court, in *Tasini*, acknowledged and adopted the legislative prohibition: no publisher, in a Section 201(c) application, should be "permitted to reproduce or distribute copies of the author's contribution . . . within new collective works." 121 S. Ct. at 2389. The Court's discussion of context with reference to the "in isolation" issue did not reach, much less diminish, the import of the prohibition against new collective works.

Thus, a "new collective work" may contain a whole issue of a magazine, or many issues, as the CNG does. *It is still a new collective work*. Neither the House Report, nor this Court, both cautioning against republication in a "new collective work," imposes any requirement or limitation as to the contents of such a work. What constitutes a "new collective work" is a matter of law to be determined within

the definitional framework of the Copyright Act, and the Eleventh Circuit correctly made that determination, as set forth below.

The Petitioners urge that, because the *Tasini* Court did not examine whether the databases there comprised a new collective work, this Court considered that analysis unimportant in any setting. However, the Court's finding that the authors' articles were reproduced in total isolation meant that none of the three permissible uses in Section 201(c) could possibly apply. Therefore, it was not necessary for this Court to reach the issue whether the databases containing the news articles also constituted new collective works.

In the matter of context, *Greenberg* could not be more aligned with *Tasini*.

B. The Microform Comparison

Completely contrary to the Petitioners' assertion, the *Tasini* Court did not hold that microform (microfilm or microfiche) reproduction qualifies for the Section 201(c) privilege. Arguably, such reproduction may qualify, but *that issue was not before the Court and the Court did not decide it.*[4] The topic provides no basis to suggest a "conflict" with *Tasini*.

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4. Because microform is utilized almost exclusively for archival purposes in libraries, it is likely that the question has never been litigated. Even the Petitioners agree (Pet. at 17 n.3) that "very few (if any) individuals buy microfilm or microfiche . . . ." *See also* 121 S. Ct. at 2392 n.12, where the Court emphasizes that the Copyright Act, in Section 108, provides special authorizations to libraries for the very limited reproduction of works for purposes related to scholarship and research.

Microform arose in the Court's discussion of the "context" contemplated in Section 201(c), wherein the Court observed that an end user confronts the authors' articles in the databases at issue in *Tasini* "disconnected from their original context." 121 S. Ct. at 2391. The only "original context" for an author's article was the newspaper — the collective work — in which it originally appeared. By comparison with the databases, the Court observed that an end user rolling through a spool of microfilm encounters the authors' articles in context, "in precisely the position in which the articles appeared in the newspaper." *Id.*

The Petitioners seize on that language to propose that "the *Tasini* Court went out of its way to note that the reproduction of a collective work in microfilm or microfiche ["microform"] *does* qualify for the privilege" (Pet. at 10 (emphasis in original)). First, the Court did not so hold. Second, even if it had, the microform described by the Court would present an end user with the original context of "that particular collective work" referenced in Section 201(c). As the Eleventh Circuit correctly held, the CNG went far beyond any "original context" attached to "that particular collective work," *i.e.*, a monthly magazine.

The CNG is as comparable with microform as a race car is to a horse. As explained next, the CNG contains crucial elements not present in microform reproductions.[5]

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5. Petitioners suggest that microform reproductions also include "independently copyrightable" elements such as an introductory page and an index. (Pet. at 13.) Whether such elements are copyrightable is highly questionable. In any event, the record below contains no evidence whatsoever as to microforms, and the facts utilized on the subject by the Petitioners are gratuitous and inappropriate for argument to this Court.

C. Reproduction in CD-ROM, a Different Medium, is Not an Issue

In an extraordinary misstatement, Petitioners assert that *Greenberg* "gives freelancers the power to stop publishers from creating electronic archives of their collective works." (Pet. at 2). The Eleventh Circuit *did not hold* that reproduction of the Greenberg photographs in a different, electronic medium would be inherently impermissible.

In *Tasini*, the Court said that "unlike the conversion of newsprint to microfilm, the transfer of articles to the Databases does not represent a mere conversion of intact periodicals . . . from one medium to another." 121 S. Ct. at 2392. Similarly, the Eleventh Circuit said: "The Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium . . . [H]owever, this case is both factually and legally different than a media transformation." 244 F.3d at 1273 n.12. Because in *Greenberg* the end user encounters significant new elements in a completely new collection, the conversion of magazines into the CNG is also not a "mere conversion of intact periodicals," as this Court observed in *Tasini*. 121 S. Ct. at 2392.

With more than a touch of hyperbole, Petitioners imply that the Eleventh Circuit has adopted a Luddite view of technology. The outcome in *Greenberg*, they propose, would stop publishers from using technological advances and return publishing to the dark ages. (Pet. at 13). The Eleventh Circuit said nothing to support such a draconian outcome. Every CD-ROM does indeed require at least minimal software to permit page-by-page access to printed matter reproduced in a digital format. But the CNG goes far beyond what is

minimally necessary in digital technology. Each of the 30 discs in the product contains features that no microform reader at the local library will ever see, including the following:

- An animated globe logo with music
- A National Geographic Interactive visual montage with sound
- A Kodak advertisement with voice and music
- An electronically-morphed sequence of magazine covers with music
- Word-search capability
- Advanced search capability using Boolean operators, wildcards, truncated words
- Feature for saving search results
- Article-by-article inspection
- Interactive link with the NGS web site
- Bookmark feature
- Button for printing any page displayed on screen[6]

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6. The Petitioners told the Eleventh Circuit that the copy quality was inferior, and provided examples. (Brief in Opp. to Initial Brief, Ex. A.) Greenberg demurred, and filed with the court samples of high-quality color copies printed from the CNG product. (Reply Brief of Jerry Greenberg, Ex. 1.)

Those items[7] are not essential for a CD-ROM product created only for page-by-page screening of magazines, *as a microform user would expect to find*. Instead, as the Eleventh Circuit properly found, they announce that the CNG is a "new product ('an original work of authorship'), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c)." 244 F.3d at 1273. The transfer to a different medium has nothing to do with the ultimate issue.

Significantly, the Court in *Tasini* found two CD-ROM products to be infringing — *not* because they involved digital technology, but because they reproduced news articles in a manner outside the privilege provided in Section 201(c). *See* 121 S. Ct. at 2382, 2394.

The medium is not the issue. The creation of a new collective work guided the Eleventh Circuit's finding of copyright infringement.

II. THE ELEVENTH CIRCUIT'S DECISION IS FULLY CONSISTENT WITH SECTION 201(c) AND ITS LEGISLATIVE HISTORY

A. Two Bases for the *Greenberg* Conclusion

The Eleventh Circuit identified three components of the new collective work. The 1200-plus monthly magazines (each is a separate collective work) were labeled by the court

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7. While the Eleventh Circuit did not specifically address each of the Program features in the list above, those features are part of the Replica, the Sequence, and the Program discussed at length by that court. Many of the features listed are separately copyrightable.

as "the Replica." Another element is the morphing sequence of moving covers that appears at the front of each disc and plays each time a disc is opened; the court called it "the Sequence" (as discussed below, the Sequence is the basis for a completely separate claim by Greenberg). A third element, referred to by the court as "the Program," consists not only of the basic software that permits each page of each magazine to be displayed in turn, but all of the myriad additional features listed above that go far beyond basic software necessary for the CD-ROM to operate.[8]

The Eleventh Circuit ruled that the CNG was a new work outside the privilege in Section 201(c) on two bases: a failure to satisfy the statutory language set forth in that section, and a failure to avoid the Congressional prohibition.

First, the court said that, even if the aggregated 1,200 issues of the magazine themselves — what the court called the Replica — could be said to be within the privilege (the court expressly did not decide), "*we are unable to stretch the phrase 'that particular work' [in Section 201(c)] to encompass the Sequence and Program elements as well.*"[9] 244 F.3d at 1272 (emphasis and bracketed material added). Second, the court held that the CNG, with its component

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8. In the court below, the Petitioners — searching for the viability of *some* part of Section 201(c) — began referring to the CNG as a product that may satisfy the "revision" clause. The court responded succinctly by saying that "[i]n layman's terms, the instant product is in no sense a 'revision.' " 244 F.3d at 1272. Petitioners reassert the proposition in their brief. (Pet. at 9).

9. Petitioners stated that the court below "made no effort to tie [its] holding to the language of the statute . . . ." (Pet. at 6). The passage in the text above, quoted from the opinion, belies that.

elements of Replica, Sequence, and Program, qualifies under the Copyright Act as a collective work, and moreover, that work is new. *Id.* That, said the court, runs afoul of the Congressional direction that contributions such as Greenberg's photographs may not be placed in a new and different collective work. *Id.*

It is undisputed that if the Petitioners had merely reprinted "that particular collective work" — the four monthly magazines in which Greenberg's photographs appear — they would have availed themselves of the presumptive privilege in Section 201(c). But Petitioners did much more.

It is helpful to review the definition of "collective work" set forth in the Copyright Act. "A collective work is a work, such as a periodical issue, anthology,[10] or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. Here, the CNG is unquestionably a new "work" in which a number of contributions — consisting of hundreds of separate and independent magazines, *and other creative elements* — are assembled into a collective whole. The CNG, the Eleventh Circuit said, is a new work "that is copyrightable as an entity separate and distinct from its constituent, pre-existing separately copyrightable contributions." 244 F.3d at 1271.

In reaching that conclusion, the Eleventh Circuit relied, among other things, on the National Geographic Society's

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10. The House Report, at 122-23, said that a publisher could not include an author's contributions "in a new *anthology* or an entirely different magazine or other collective work." (Emphasis added). If nothing else, the CNG qualifies as an anthology.

admissions in a registration form filed in 1998 with the Copyright Office. The form shows that: (a) the work being registered was a product titled "108 Years of National Geographic Magazine on CD-ROM," (b) the work had never existed before, and (c) the new work was a "compilation." 244 F.3d at 1273 and App. A thereto. The court noted that a collective work is encompassed in the statutory definition of a compilation. *Id.* In *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 388 n.6 (5th Cir. 1984), the court observed that "[c]ompilations consisting of contributions which are themselves 'works' capable of copyright protection are called 'collective works.' " *See also Southern Bell Tel. & Tel. v. Assoc. Telephone Directory Publishers*, 756 F.2d 801, 810 (11th Cir. 1985) ("a collective work is itself a compilation").

In their brief filed below, Petitioners never acknowledged the admissions contained in the registration form. They also avoided the matter entirely in their petition, disparaging the Eleventh Circuit's interest in the registration form as "a frolic and detour." (Pet. at 19.) Petitioners cannot evade the reality that they registered a work, that had never existed before, as a compilation in the form of a collective work — as the Copyright Act and the courts define those terms. Petitioners lately have attempted to cloud the matter of exactly what was registered with the Copyright Office.[11] However, in a memorandum filed with the district court below, Petitioners represented to the court as follows: "[T]he work registered in the Form VA was CD-ROM 108 — not the Moving Cover

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11. Petitioners state that the Society claimed copyright only in a "brief introductory audiovisual montage," an apparent reference to the Sequence. (Pet. at 5). The representation to the district court below conflicts directly.

Sequence. In registering its copyright interest in CD-ROM 108, the Society, in the interest of full and fair disclosure, merely indicated the presence of a small amount of material in addition to that which existed previously."[12]

If, as Petitioners contend, the CNG is nothing more than a huge bundle of reprints of magazines (each is protected by its own copyright registration), why would registration of the entire new product be necessary? "Copyright in [a] collective work vests in the collective author (here . . . the magazine publisher) and extends only to the creative material contributed by that author, not to 'the preexisting material employed in the work.' " 121 S. Ct. at 2387 (quoting 17 U.S.C. § 103(b)). The Society would hardly seek protection for something new that it did not consider valuable and deserving of protection. The Eleventh Circuit rightly concluded that the registration was of a completely new collective work, which is not protected by Section 201(c).

Finally, to emphasize what they believe to be the Eleventh Circuit's improper reliance on the congressional admonition against new collective works, Petitioners suggest that the House Report itself authorizes new collective works, such as "a later issue of its magazine" and the publication of a new edition of an encyclopedia. (Pet. at 16.) Those are express, narrow exceptions to the prohibition against inclusion of an author's work in an "entirely different magazine or other collective work." House Report at 122-23. A "later issue" and a "new edition" are not the same

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12. *See* Defendants' Motion to Strike Plaintiffs' Supplemental Memorandum in Support of Plaintiffs' Motion to Vacate Order Granting in Part Defendants' Motion for Summary Judgment at 6 (Docket number 68).

thing as an "entirely different magazine or other collective work." As the *Tasini* Court observed, "[s]ection 201(c) both describes and circumscribes" the privilege available there. 121 S. Ct. at 2389.

B. The Speculation About Harm is Misplaced

Escalating the argument that the Eleventh Circuit's decision will return publishing to an ancient time, Petitioners urge that if a computer program is sufficient to defeat the privilege, "then Section 201(c) would *never* permit the reproduction of collective works in CD-ROM or other electronic media" (Pet. at 13 (emphasis in original)). Such concerns were directly repudiated by the Court in *Tasini*: "[S]peculation about future harms is no basis for this Court to shrink authorial rights Congress established in § 201(c)." 121 S. Ct. at 2394.

Despite Petitioners' foreboding, publishers are always free to employ digital technology, in circumstances where Section 201(c) is involved, in two stratagems. First, a publisher wanting to reproduce an author's work in a digital format can satisfy Section 201(c) by utilizing a software program that simply stores the work and allows page-by-page display.

Alternatively, a publisher is quite free to include all kinds of marketable elements, like those in the CNG, to create new collective works or anthologies that are outside the Section 201(c) privilege. In that circumstance, the publisher may deal with an author's copyrighted contributions by negotiating payment for their use, through royalties or a similar arrangement — steps that Petitioners never claim to have attempted here. In such situations the parties, said the Court,

"may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution." 121 S. Ct. at 2393.

Petitioners complain that in a retroactive sense "it is impossible as a practical matter for . . . publishers (like National Geographic) to reach retroactive license agreements with all of their past freelance contributors." (Pet. at 17). Petitioners do not bother to explain why it is impossible. The only outcome, they exclaim, is the "destruction" of a valuable historical archive like the CNG. *Id.* The publishers in *Tasini* also raised the specter of destruction, but the Court rejected such "dire predictions." The Court said that it hardly follows that an injunction must issue to bar continued use of the authors' articles. 121 S. Ct. at 2393. The *Tasini* and *Greenberg* courts said that injunctions that would require removal of contributors' works were not foregone outcomes on remand to the district courts. In *Greenberg*, the court said: "In assessing the appropriateness of any injunctive relief, we urge the [district] court to consider alternatives, such as mandatory license fees, *in lieu of foreclosing the public's computer-aided access to this educational and entertaining work*." 244 F.3d at 1276 (emphasis added). Those are not the words of an anti-technology court.

Lost in all of the alarms about the handcuffing of publishers is the necessity to preserve the copyright balance set forth in the Constitution[13] by protecting authors' legitimate rights. The *Tasini* Court observed that Section

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13. Article II, Section 8, provides in pertinent part: "The Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."

201(c) "adjusts a publisher's copyright in its collective work [here, a monthly magazine] to accommodate a freelancer's copyright in her contribution. If there is demand for a freelance article standing alone *or in a new collection*, the Copyright Act allows the freelancer to benefit from that demand . . . ." 121 S. Ct. at 2389 (emphasis added).

III. THE "FRAUD" ISSUE RAISED BY THE PETITIONERS IS WHOLLY INAPPROPRIATE FOR REVIEW HERE

Only two questions were presented by Petitioners for the Court's consideration. The second question reads as follows:

> Whether an applicant for a copyright registration perpetrates a "fraud" on the Copyright Office when the applicant discloses "the material . . . in which copyright is claimed," as the Copyright Office requires, and the Copyright Office itself insists that the applicant provided full disclosure.

Pet. at 2. The question is a marvel of irrelevance. The subject matter was addressed by the Eleventh Circuit in footnote 13 of its decision, and nowhere else. The discussion in the footnote is dictum that in no way was relevant or essential to the court's holding of copyright infringement. The point requires no elaboration. This Court should reject the issue out of hand.

Petitioners even got the dictum wrong, in their assertion that in footnote 13 the Eleventh Circuit "accus[ed] National Geographic of having 'perpetrated a fraud' on the Copyright Office . . . ." (Pet. at 18.) The court below did not go so far.

It said: "Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office." 244 F.3d at 1273 n.13. Petitioners twisted that sentence into the following: "The [Eleventh Circuit] then accused the Society of having 'perpetrated a fraud on the Copyright Office' " — albeit, "[g]iving the Society the benefit of the doubt," perhaps "not . . . intentionally." (Pet. at 19.)

Petitioners make a weak attempt to relate the contents of footnote 13 to the Eleventh Circuit's holding with respect to a new collective work. (Pet. at 19.) But in the discussion by the court below of the registration filing, *see* 244 F.3d at 1273, what appears in footnote 13 of that opinion is simply an aside that touches on a question that was not before the court.

Of some moment, however, is that Petitioners improperly have included in their appendix a letter from the Copyright Office that was obtained ex parte after the Eleventh Circuit's opinion issued, was excluded by the court from the record below, is not suitable for judicial notice (the general counsel's letter responded to a letter of inquiry by the Society), and that contains commentary on substantive matter pertaining to this case entirely apart from the "fraud" issue. The letter should be stricken or ignored.

Item 2 in "Questions Presented" falls far short of any of the criteria generally understood to be the basis for certiorari review by this Court.

IV. THE RULING ON GREENBERG'S SECOND CLAIM BELOW HAS NOT BEEN CHALLENGED AND SHOULD NOT BE DISTURBED

In a completely separate claim in his complaint, Respondent Jerry Greenberg also alleged an infringement of his copyright in a photograph that became part of what his lawsuit called the Moving Cover Sequence which is displayed at the start-up of each CD-ROM disc in the CNG. What the Eleventh Circuit referred to as "the Sequence" is an artfully designed electronic "morphing" of ten covers selected from among the 1200-plus magazines in the CNG.

The Eleventh Circuit held that the Sequence is "at once a compilation, collective work, and with reference to the Greenberg photograph, a derivative work" that infringes Greenberg's copyright in the photograph that was used. 244 F.2d at 1274.

Petitioners did not identify that holding of infringement with the other "Questions Presented" in their brief, and thus waived any challenge to the holding. The *only* tangential discussion in the petition of Greenberg's claim regarding the Sequence is in footnote 2, where Petitioners contend that the Eleventh Circuit's "erroneous interpretation of Section 201(c) necessarily infected its fair use and *de minimis* analysis as well . . . ." (Pet. at 17 n.2). The brief incorrectly states that the holding by the court below "was expressly based in part on the court's conclusion that the 'moving covers' sequence was 'an integral part of a larger, new collective work' outside the scope of Section 201(c)." *Id.* (citation omitted). What the court actually said was otherwise: "[Greenberg's photograph] became an integral part of a larger, new collective work." 244 F.3d at 1274.

The "larger" work referenced in that discussion was the Sequence. In its analysis of the Sequence the court never mentioned Section 201(c), nor was that section ever raised by the Petitioners below as a justification for using Greenberg's photograph in the Sequence.

Petitioners did not challenge in their brief in any way the Eleventh Circuit's analysis and rejection of their *de minimis* and fair use defenses with respect to the Sequence. The only basis proposed in the petition in footnote 2 for review by this Court is some purported linkage between the separate Sequence claim and Section 201(c). The Eleventh Circuit attempted no such linkage, nor did the Petitioners themselves in briefing that court. The Eleventh Circuit's holding with reference to the Sequence claim should not be disturbed.

CONCLUSION

The *Tasini* Court's ultimate conclusion bears repeating: "It would scarcely 'preserve the author's copyright in a contribution' as contemplated by Congress, if a . . . magazine publisher were permitted to reproduce or distribute copies of the author's contribution in isolation or within *new collective works*." 121 S. Ct. at 2389 (citations omitted) (emphasis added).

The Eleventh Circuit's holding that, as a matter of law the CNG is a new collective work, was consistent with this Court's conclusions as to the law. As such, the CNG is beyond the privilege contained in Section 201(c), and the Eleventh Circuit's opinion is solidly grounded in law. Respondents submit that *Greenberg* requires no review here.

Respectfully submitted,

NORMAN DAVIS
Counsel of Record
STEEL HECTOR & DAVIS LLP
Attorneys for Respondents
4000 First Union Financial Center
200 South Biscayne Boulevard
Miami, Florida 33131-2398
(305) 577-2988

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IN THE

Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY;
NATIONAL GEOGRAPHIC ENTERPRISES, INC.;
AND MINDSCAPE, INC.,
Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF *AMICI CURIAE* OF THE AMERICAN LIBRARY ASSOCIATION, THE ASSOCIATION OF RESEARCH LIBRARIES, THE AMERICAN ASSOCIATION OF LAW LIBRARIES, AND THE MEDICAL LIBRARY ASSOCIATION IN SUPPORT OF PETITIONERS

PETER JASZI
WASHINGTON COLLEGE OF LAW
AMERICAN UNIVERSITY
4801 Massachusetts Ave., N.W.
Washington, DC 20016

ARNOLD P. LUTZKER
Counsel of Record
CARL H. SETTLEMYER, III
LUTZKER & LUTZKER, LLP
Suite 450
1000 Vermont Avenue, N.W.
Washington, DC 20005
(202) 408-7600

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

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INTERESTS OF *AMICI CURIAE* [1]

This brief *amici curiae* in support of Petitioners is submitted by the American Library Association, the Association of Research Libraries, the American Association of Law Libraries, and the Medical Library Association ("*Amici*") pursuant to Rule 37 of the Rules of this Court. *Amici* urge that the Court grant the requested writ of certiorari and reverse the judgment of the U.S. Court of Appeals for the Eleventh Circuit.

The **American Library Association** ("ALA") is a nonprofit educational organization of approximately 61,000 librarians, library educators, information specialists, library trustees, and friends of libraries representing public, school, academic, state, and specialized libraries. ALA is dedicated to the improvement of library and information services and the public's right to a free and open information society.

The **Association of Research Libraries** ("ARL") is a nonprofit association of 123 research libraries in North America. ARL's members include university libraries, public libraries, government and national libraries. Its mission is to shape and influence forces affecting the future of research libraries in the process of scholarly communication. ARL programs and services promote equitable access to and effective uses of recorded knowledge in support of teaching, research, scholarship and community service.

The **American Association of Law Libraries** ("AALL") a nonprofit educational organization with over 5,000 members nationwide. AALL's mission is to promote and enhance the value of law libraries to the legal and public communities, to

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[1] Letters from all parties consenting to the filing of this brief have been filed with the Clerk of this Court. No counsel for a party authored this brief in whole or in part, and no person or entity other than amici curiae, or their counsel, made a monetary contribution to the preparation or submission of this brief.

foster the profession of law librarianship, and to provide leadership in the field of legal information and information policy.

The **Medical Library Association** ("MLA") is a professional organization of more than 5,000 institutions and individuals in the health sciences information field. MLA members develop programs for health sciences information professionals, and health information delivery systems, foster educational and research programs for health sciences information professionals, and encourage an enhanced public awareness of health care issues.

* * * * *

Amici are organizations devoted to representing the interests of institutions and professionals responsible for collecting and preserving historical, scholarly and other records, including periodicals and other collective works, and for making these materials available to researchers and the public at large. These institutions and individuals assist their patrons in researching, retrieving and using these materials in traditional paper media, in microform, in CD-ROM and other multi-media formats and via online services and the Internet. A significant part of their mission is to make available reliable, accessible, comprehensive repositories of back issues of newspapers, magazines, journals and other periodicals. Many institutional and individual members of *amici* use the very CD-ROM product at issue in this case. For these reasons, *amici* submit this brief to assist the Court's understanding of the practical implications of the issues at stake in this case.

SUMMARY OF ARGUMENT

The Eleventh Circuit held in this case [2] that Section 201(c) of the Copyright Act (17 U.S.C. §201(c)) does not confer upon

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[2] The opinion below and appendices thereto are reproduced in the "Appendix" to the "Petition for Writ of Certiorari" filed with this Court. Petition Appendix ("App.") 1a-21a.

Petitioners the privilege of reproducing and distributing the copyrighted works of freelance photographers as part of a CD-ROM product ("*The Complete National Geographic*"). In that product, however, the freelance photographs are perceptibly reproduced and distributed as part of the original collective works, or revisions thereof, in which they first appeared. This ruling is therefore inconsistent with the Copyright Act of 1976, as amended (the "Act"), and with this Court's recent decision in *The New York Times Co., Inc. v. Tasini*, 121 S. Ct. 2381 (2001) ("*Tasini*"). The circuit court's ruling deems unlawful what is effectively the mere conversion of intact periodicals from one medium to another. It cannot be squared with a "media neutral" copyright system. It is also likely to impact negatively libraries and their patrons for many years to come.

This Court's jurisprudence has recognized that a fundamental goal of copyright law is to promote "broad public availability of literature, music, and the other arts" through a system of private reward to authors. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). At base, its decision in *Tasini* was about fair compensation to individual authors when commercial electronic database publishers reused articles without additional permission to create new collective works and sell articles on an individual basis. Thus, it protected the author's private reward pursuant to the balance that Congress struck in enacting Section 201(c) of the Act.

The instant case, by contrast, is ultimately about the other side of that balance. It is about the ability of collective work owners covered by Section 201(c) to take advantage of new technologies to more broadly distribute those creative works to the public. The Eleventh Circuit's flawed decision upsets that balance. Carried to its logical conclusion, the ruling raises the specter of Section 201(c) being frozen in time, exclusively applying to older, non-digital technology to the detriment of research, scholarship and learning. The Eleventh Circuit was

certainly cognizant of the issues of public access raised by this case. It suggested ways to construct a remedy in this case that would protect both the interest in fairness to freelance photographers and the public interest in access to their works in the context of the Petitioners' CD-ROM product. But in the final analysis, no remedy whatsoever appears to be necessary in this case because no wrong has been committed.

The Eleventh Circuit's decision is legally erroneous because it fails to focus on the Petitioners' acts of reproducting and distributing the photographers' individual works "as part of" the original collective works or permissible revisions thereof, and disregards how the works are "presented to, and perceptible by, the user. . . ." *Tasini*, 121 S. Ct. at 2390. Rather, the appeals court finds impermissible under Section 201(c) the combination of digital facsimiles of entire collective works with computer software that will enable users to search and perceive them with the aid of a machine or device.[3] This is an outcome not mandated by the statute. It is squarely inconsistent with the "media neutral" terms of the relevant portions of the Act. It is also contrary to this Court's holding in *Tasini* that the proper focus of the inquiry under Section 201(c) is how the product "perceptibly presents the author's contribution" to the product's end-user. *Id.* at 2393. From the end-user's perspective, the product at issue in this case is essentially "a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another." *Id.* at 2392. The product at issue in this case embodies digital fixations that are materially the same as the type of analog microfilm collections that this Court has already observed are permissible under Section 201(c). *Id.* at 2391-92. The freelance photographs are

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[3] The Eleventh Circuit opinion refers to the digital facsimiles of the magazines comprising *The Complete National Geographic* as the "Replica." It collectively refers to the search engine and the program for compressing and decompressing the digital images comprising the Replica as the "Program". App. 3a-5a.

perceptible to the end users of this product "as part of" the original collective works, just as they are to the end-users of a roll of microfilm. The software elements of the product function in a manner similar to a lens, light, and knobs used to view and search a microfilm copy of a work.

As a consequence of the flaws in its legal analysis, the Eleventh Circuit has issued a decision that materially and adversely affects libraries and their patrons in a number of ways. If this decision stands, it would inhibit the dissemination of collective works via digital and electronic media that involve combining digital facsimiles of complete collective works with software that enables a user to perceive them. This would thwart broader public availability not only of popular works like those of Petitioner National Geographic Society, but also less widely accessible periodicals. Digital and electronic media also have functionality that exceeds traditional analog media as well as the potential for greater utility in the future as archival and preservation media. This ruling stymies the adoption and evolution of such useful technologies. Finally, CD-ROM and online versions of newspapers and magazines can greatly reduce the space requirements of many libraries. Their use can often improve public access to greater amounts and sources of materials. The Eleventh Circuit's erroneous decision needlessly deprives the public of that benefit.

ARGUMENT

The Eleventh Circuit held that Section 201(c) of the Copyright Act does not confer upon Petitioners the privilege of reproducing and distributing the copyrighted works of freelance photographers in and through a certain CD-ROM product. Although superficially similar to this Court's ruling in *Tasini* (i.e., both courts ruled that the publishers before them had no right under Section 201(c) to reproduce freelance contributions in certain electronic contexts), the Eleventh Circuit's ruling is, in fact, fundamentally at odds with this Court's decision. In

Tasini, the Court ruled that the Section 201(c) privilege did not apply to the works of freelance authors whose works had been reproduced in commercial online electronic databases and CD-ROM products and distributed to the public in a manner other than "as part of" the types of collective works specified by Section 201(c). The Eleventh Circuit's decision (which was issued before *Tasini* was decided) holds that freelance photographic contributions that are reproduced and distributed as part of digital facsimiles of complete issues of magazines embodied in CD-ROMs are not permissible under Section 201(c). It reaches this conclusion even though the CD-ROM versions appear to the end user to be mere conversions of the intact periodicals from the print medium to a digital medium.

It may be unusual for the Court to face multiple calls, in such quick succession, to construe a seemingly arcane provision of the Copyright Act. However, *amici* believe that the practical consequences of the Eleventh Circuit's decision may be even more far-reaching than the decision in *Tasini* in terms of the impact on the public availability of copyrighted works and the development of new media collections. This Court's review will therefore be particularly important for publishers of collective works and users of collective works nationwide. This Court could simply vacate and remand the Eleventh Circuit's decision and instruct it to re-visit its decision in light of *Tasini*. This might give the lower court a chance to correct the flaws in its decision.[4] But that decision rests in substantial

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[4] In addition to the issues discussed more fully in this brief, other aspects of the Eleventh Circuit's opinion are analytically questionable. For instance, in its fair use analysis concerning the opening audiovisual sequence in which a Respondent's magazine cover photograph is depicted, the court appears to have weighed the transformative nature of the Petitioners' use of the photo *against* a finding of fair use. App. 14a. This Court's precedent clearly indicates precisely the opposite result. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (the goal of copyright is generally furthered by the creation of transformative works). *Amici* take no position as to whether, given a proper application of Section 201(c), the fair

part on reasoning that would altogether bar application of Section 201(c) in a digital environment, even if the product in question otherwise met all the requirements of Section 201(c). The Eleventh Circuit's flawed rationale goes beyond the issues addressed by this Court directly in *Tasini* and would be expected to persist in a subsequent appellate court decision. Thus, the issues presented herein would be likely to be presented to this Court again in the near future. It would therefore be more efficient, and of greater public benefit, for the Court to address them directly now.

I. THE ELEVENTH CIRCUIT'S DECISION IS NOT ONLY CONTRARY TO SECTION 201(C) AND THIS COURT'S OPINION IN *TASINI*, IT ALSO FINDS INFRINGMENT BASED ON A MERE CONVERSION OF WORKS INTO A MEDIUM REQUIRING A MACHINE OR DEVICE TO PERCEIVE THEM

A. This Case Involves A Product Distinguishable From Those At Issue In *Tasini*

As construed by this Court, it is permissible under Section 201(c) for the owner of a collective work copyright to

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use issue should have been resolved against Petitioner in the summary judgment context, or if the fleeting use of this photograph is so *de minimis* that it should not be actionable. At the very least, the fair use analysis should be undertaken anew in light of an understanding that Petitioners' principal use of the photographs in the CD-ROM product was proper under Section 201(c). Likewise, the Eleventh Circuit's holding that Petitioners perpetrated a "fraud" on the Copyright Office (App. 11a-12a), should be reconsidered in the context of a correct application of Section 201(c), after full briefing by the parties. Because the ruling implicates issues of national uniformity in matters of copyright registration, the views of the U.S. Copyright Office should also be fully considered. Finally, the appeals court speaks in sweeping language of the "constitutionally-secured rights of the author" (App. 9a) with little meaningful analysis or discussion. If necessary to a decision in this case, this topic would also merit a more extensive discussion and consideration of diverse viewpoints.

reproduce an exact facsimile of the complete collective work, whether in paper or other forms, such as microfilm and microfiche. *Tasini*, 121 S. Ct. at 2391-92. This would be true even if multiple, exact reproductions were combined into a single package in which several entire issues of a series of collective works would be distributed as a unit (like traditional microfilm). *Id.* at 2391. When one distributes the constituent works in this manner, one is both reproducing and distributing them "as part of" the original collective works, as provided for in Section 201(c), including all of the selection, coordination, and arrangement of the original collective works. These practices, which are not problematic under this Court's decision in *Tasini* when applied to traditional media, become impermissible under the Eleventh Circuit's decision below if the exact facsimile is in digital form with supporting software. This conclusion is not required by or consistent with *Tasini*.

In *Tasini*, this Court was faced with three different electronic database products and held that none of them complied with the requirements of Section 201(c). One product was the NEXIS online database in which millions of articles in electronic file format from thousands of periodicals had been reproduced and made available online to users, in effect, on an individual basis. *Tasini*, 121 S. Ct. at 2392. The other two were CD-ROM products. One of these, known as "GPO," was image-based. It showed each article exactly as it appeared on the printed page, *but the CD-ROM contained articles from approximately 200 publications or sections of publications. Id.* The other CD-ROM product contained only the *New York Times*, *but it did not have the original formatting or accompanying images from the original publication. Id.* Both of the CD-ROM products in *Tasini* displayed the articles *in such a way that they were not linked to other articles appearing in the original print publications* and the user who wished to see other pages of the original collective work could not simply "flip" to them. A new search was required. *Id.* at n.2. These characteristics

destroyed the claim that the reproductions and distributions of the articles therein were "as part of" qualifying collective works.

In deciding that these products were not permissible under Section 201(c), the Court's focus in *Tasini* was on the freelance articles "as presented to, and perceptible by, the user" of the commercial electronic databases before it. *Id.* at 2390. The Court's inquiry was "whether the database itself perceptibly presents the author's contribution as part of" the collective work or revision thereof. *Id.* at 2393. The products in *Tasini* presented freelance articles to users "clear of the context provided either by the original periodical editions or by any revision of those editions." *Id.* at 2390-91. The products did not perceptibly reproduce and distribute the freelance articles "as part of" the original periodicals or permissible revisions. *Id.* at 2391. Significantly, the products offered users individual articles, not intact periodicals, and did not involve "a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another" as happens with microfilm. *Id.* at 2392.

Turning to the product before the Eleventh Circuit below, *The Complete National Geographic* is fundamentally a mere conversion of intact print periodicals into the medium of CD-ROMs. The freelance photographs alleged to be infringed appear in the CD-ROM versions *in the exact positions* in which they appeared in the original print version of the magazines. The photographs are presented in the context of the full, original issues (even with original advertising). App. 4a. In addition, a user of the CD-ROM can "flip" to other articles and pages in the digital facsimile of an issue in the same order in which those articles and pages were originally presented in the printed editions. Although there are 100 years of issues reproduced on multiple discs, *National Geographic* is the only periodical that appears in the CD-ROM version. A user encounters very few materials that have been added to the

CD-ROMs that are not digital facsimiles of the original magazines or software that permits viewing them and searching them for specific issues and articles. These added materials perceptible to users are apparently a few short advertising videos, a start-up video montage that lasts for a few seconds, and a chronological table of contents.[5]

Thus, the freelance photos are reproduced and distributed to the public "as part of" the original collective work or revision of the original collective work. The freelance photographs are not being made available on a piecemeal basis or being sold a la carte out of a database that combines multiple periodicals. *Cf. Tasini*, 121 S. Ct. at 2392. The photographs are not stored and retrieved "separately within a vast domain of diverse texts" (*id.* at 2393) and the reproduction and distribution of the photographs in the context of digital facsimiles of the original periodicals does not effectively override the photographers' exclusive right to control the individual reproduction and distribution of each photograph. *Cf. id.* In all material regards, the photographs are perceptibly reproduced as part of the digital facsimiles of the original *National Geographic* magazines. These CD-ROMs are therefore materially distinguishable from each of the products at issue in *Tasini*.

B. The Flaws In The Eleventh Circuit's Analysis

The Eleventh Circuit's decision fails to reflect the relevant distinctions between the product at issue before it and those at issue in *Tasini*, in part, because that court issued it before gaining the benefit of this Court's analysis articulated in *Tasini*.

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[5] For purposes of Section 201(c) these additional elements ought to be deemed merely incidental and of no significance to the status of the CD-ROM as a qualifying reproduction. They do not alter the essence of the digital facsimiles embodied in Petitioners' CD-ROM and have no separate value to the product's user. They are of no greater significance than putting a new cover on a book or adding a table of finding aids to the head of a microfilm roll.

But the appeals court decision contains an additional flaw in its reasoning. The opinion suggests that it is impermissible under Section 201(c) for a collective work owner to combine into a single product the digitized text and images of a complete collective work with software that enables users to perceive and search the collective work with the aid of a computer. Under the Eleventh Circuit's reasoning, the addition of search and access software to a product containing digitized periodicals is, in effect, *per se* impermissible under Section 201(c). The court claimed in its opinion not to decide that issue. App. 11a, n.12. However, the software issue is clearly the dominant element of its analysis. *Id.* Consistently applying the appeals court's ruling would mean that no publisher could rely on Section 201(c) to release a collection of its works in CD-ROM or digital format because of the use of supporting software. *Amici* believe this analysis to be an error that could materially diminish public access to works and reduce the dissemination of collective works reproduced and distributed in digital form in a manner consistent with Section 201(c) as explained in *Tasini.*

In *The Complete National Geographic*, the original collective works that are reproduced in digital facsimiles are not themselves changed by the conversion from paper to CD-ROM. In this regard, there is merely a transformation from analog to digital media. The necessity of using an additional "work", i.e., another computer program, to view the unchanged collective works should be analytically irrelevant because under the Act, a copy of a work that is perceptible without a machine or device stands on equal footing with one that does. The Act provides that copyright protection adheres to works of authorship "fixed in *any* tangible medium of expression, *now known or later developed*, from which they can be perceived, reproduced, or otherwise communicated, either directly or *with the aid of a machine or device*." 17 U.S.C. §102(a) (emphasis added). *See also* 17 U.S.C. §101 ("copies" defined as material objects in which a work "is fixed by *any* method *now known or*

later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or *with the aid of a machine or device.*") (emphasis added).

The product at issue in this case embodies digital fixations that are materially similar to the type of analog microfilm collections that this Court has already observed are permissible under Section 201(c).[6] The freelance photographs are perceptible to the end users of this product "as part of" the original collective works, just as they are to the end-users of a roll of microfilm. The end-user encounters the software component of the product, in effect, only as part of the "machine or device" that permits the collective work to be perceived. It is functionally analogous to a lens, light, and the knobs on a microfilm viewer. It is not perceptibly presented to the end user as matter that has been added to the original collective works.

Even if the product at issue here were not to be viewed as embodying mere reproductions of the original collective works, the addition of these software elements to the digital medium could be viewed as the creation of a permissible "revision" under Section 201(c). The concept of a "revision" can encompass some level of addition and/or deletion of copyrightable matter, and nothing in the Act or its legislative history suggests otherwise. If the "final" edition of a traditional print newspaper contained additional photographs and text—both qualifying as additional copyrightable works—that were not included in the "early" edition, this could be fairly characterized as being a

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[6] "Microforms typically contain continuous photographic reproductions of a periodical in the medium of miniaturized film. Accordingly, articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper." *Tasini*, 121 S. Ct. at 2391-92. "True, the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on the Article, to the exclusion of surrounding material. Nonetheless, the user first encounters the Article in context." *Id.*

permissible "revision." Likewise, the addition of copyrightable matter that is not even perceptible to an end user as matter added to the collective work being viewed, but encountered as part of the "machine or device" that enables the user to view the collective work, could be fairly deemed to be a "revision" of the collective work.

II. THE ELEVENTH CIRCUIT'S DECISION WILL HAVE ADVERSE EFFECTS ON THE LIBRARY COMMUNITY AND USERS OF COLLECTIVE WORKS

At base, *Tasini* was about fair compensation to individual authors where commercial electronic database publishers reused articles without additional permission, created new collective works and sold articles on an individual basis. By contrast, this case is about the other side of the Copyright Act's balance between the private reward to authors and the public's access to creative works. It is about the ability of collective work owners covered by Section 201(c) to take advantage of new technologies when their use is consistent with the statutory requirements. For *amici*, the Eleventh Circuit's decision is ominous. Under it, no collective work reproduced or distributed via CD-ROM, online technology, or other new technology requiring additional software to facilitate viewing or searching could, as a practical matter, ever qualify for the Section 201(c) privilege even if the product met the statutory criteria in all other respects. The ruling therefore inhibits the dissemination of collective works via digital and electronic media.

The sweeping implication of the Eleventh Circuit's decision would, if left undisturbed, thwart broader public availability not only of well-disseminated works like those of Petitioner National Geographic Society. It would also frustrate broader public availability of more obscure, less widely accessible magazines, newspapers, scholarly journals and other periodicals. These collective works could potentially be made accessible to a broader segment of the population, but not if

digital and electronic media compilations of them are effectively *per se* impermissible under Section 201(c), as they appear to be under the Eleventh Circuit's decision. Moreover, such products make it much easier to access information resources, and make possible the retrieval and use of data in powerful ways not possible with analog media. Thus, such products are of enormous value to library patrons, particularly scholars and historians.

It bears noting that although the petitioners in *Tasini* voiced similar public access concerns in briefing that case, the Court apparently found that those concerns could not override the language of Section 201(c) as applied to the specific products at issue in that case. The Court rightly recognized that the question of continued public availability of these works could be addressed in the context of the remedial phase of the case. *Tasini*, 121 S. Ct. at 2393-94. But in this case, the product is distinguishable from those in *Tasini* and a fair application of the statute requires a different outcome. There is no need for a remedy because the collective work owner has committed no wrong against the freelance contributors. The product at issue here fully qualifies for application of the privilege under Section 201(c). Thus, neither the remedial issues nor the public access issues implicated by the Eleventh Circuit's decision need even arise.[7]

Digital and electronic media also have the potential for greater utility in the future as archival and preservation media. Petitioners' CD-ROM products and analogous online products

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[7] The Eleventh Circuit's opinion contained some insightful comments at its close in recognizing that it is appropriate to consider alternatives to injunctive relief, "such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work." App. at 16a-17a. This Court recognized similar concerns in *Tasini*. 121 S. Ct. at 2393-94.

are not electronic "archives" in the true sense of the word.[8] Nor are the particular electronic media that have been at issue here or in *Tasini* now able to serve a substantial preservation function.[9] However, other digital and electronic media more suitable to those purposes may develop in the future. They may entail reproducing a complete, digital facsimile of a collective work in combination with computer software (that is itself comprised of one or more separate "works" under the Act) that enables users to view and search the collective work with the aid of a machine or device. Indeed, libraries make significant investments in developing technologies with the goals of improving both user access and long-term preservation

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[8] For research libraries, for whom preservation and access are central to their mission, retention of paper and microfilm continues because these are the only proven preservation media. Indeed, a growing number of research libraries (almost eighty) rely upon offsite storage facilities to accommodate the burgeoning growth of their physical collections. Even research libraries that are investing heavily in electronic resources are approaching the replacement of their paper resources with caution. *See* Peter Allison & Carolyn Mills, *Library Investing Heavily in Electronic Journals*, UCONN Libraries, Feb./Mar. 2001, at 6.

[9] Electronic media may have some advantages over other media for preservation purposes and may be the only viable means for preserving certain fragile material, but electronic media "may introduce new preservation problems of their own." *Commission on Physical Sciences, Mathematics, and Applications, National Research Council, LC21: A Digital Strategy for the Library of Congress* at 6-2 (2000). In fact, digital reformatting is not yet considered a standard preservation strategy, as it is neither free from physical deterioration nor hardware and software obsolescence. Abby Smith, Council on Library and Information Resources, Why Digitize? at 3-7 (1999). Certain digital media, like magnetic tape, are inherently unstable and can degrade within a decade, *id.*, and their use as archival media presents significant logistical hurdles. *See* 36 C.F.R. § 1234.30 (regulations of National Archives and Records Administration on maintenance of electronic records storage). Even so, magnetic tape remains the archival choice over CD-ROMs, which are not at this time considered an archival medium.

capabilities. Accordingly, the decision below stymies the adoption and evolution of such media to the detriment of the public in both regards.

Finally, CD-ROM and online versions of newspapers and magazines now—and eventually other products yet to evolve—can greatly reduce the space requirements of many libraries. Thus, if this decision stands, it would have serious, adverse effects on space requirements of such institutions and potentially increase their costs. This has the collateral effect of reducing the amount of material and variety of sources available to library patrons. It is not an outcome that Section 201(c) requires and therefore constitutes an additional, gratuitous harm to libraries and their patrons.

CONCLUSION

For the foregoing reasons, this Court should grant the writ of certiorari and the judgment of the court of appeals should be vacated and reversed.

Respectfully submitted,

PETER JASZI
WASHINGTON COLLEGE OF LAW
American University
4801 Massachusetts Ave., N.W.
Washington, DC 20016

ARNOLD P. LUTZKER
Counsel of Record
CARL H. SETTLEMYER, III
LUTZKER & LUTZKER, LLP
Suite 450
1000 Vermont Avenue, N.W.
Washington, DC 20005
(202) 408-7600

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IN THE

Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC ENTERPRISES, INC., and MINDSCAPE, INC.,
Petitioners,

v.

JERRY GREENBERG and IDAZ GREENBERG,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF OF *AMICI CURIAE* AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC., *ET AL.* IN SUPPORT OF RESPONDENTS

VICTOR S. PERLMAN *
AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS
150 North Second Street
Philadelphia, PA 19106-1912
(215) 451-0884

* Counsel of Record

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BRIEF OF *AMICI CURIAE* AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC., *ET AL.* IN SUPPORT OF RESPONDENTS AND IN OPPOSITION TO THE PETITION FOR CERTIORARI

INTERESTS OF *AMICI CURIAE*

Amici Curiae American Society of Media Photographers, Inc., *et al.* (collectively "ASMP") hereby respectfully submit this brief in support of the opposition to the Petition for Certiorari filed by Respondents Jerry Greenberg and Idaz Greenberg ("Respondents"). A complete listing of the eleven organizations comprising the *amici curiae* is set forth in Appendix A to this brief.[1]

The *amici curiae* organizations supporting the Respondents in opposing the grant of certiorari in this case have a substantial interest in defending and preserving the copyrights of freelance photographers, writers, graphic artists, fine artists and cartoonists (collectively "freelance authors"). As many of these *amici* explained in their brief in support of the respondents in the recently decided case of *New York Times Co., Inc. v. Tasini*, 121 S.Ct. 2381 (2001), freelance authors represented by *amici* produce a significant portion of the material that regularly appears in periodicals such as the New York Times and National Geographic. Since freelance authors rely upon their copyrights for their livelihoods, they have strongly opposed the overreaching efforts of some publishers to use a heretofore obscure provision of the Copyright Act, 17 U.S.C. § 201(c), to deprive freelance authors of the opportunity to exploit new markets that may be available for previously published copyrighted works.

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[1] Petitioners have consented to the filing of this *amici* brief. A copy of their consent letter has been filed with the Clerk.

This brief was not authored in whole or in part by counsel for any party. No person or entity, other than *amici*, their members or their counsel, made a monetary contribution to the preparation or submission of this brief.

As in *Tasini,* the publisher here, National Geographic, has created a new product incorporating previously published copyrighted contributions by freelance authors. As in *Tasini*, the publisher here seeks cover for this unilateral act under Section 201 of the Copyright Act. And, as in *Tasini,* the republication of freelance authors' contributions to prior issues of National Geographic in the "Complete National Geographic" ("CNG"), a new CD-ROM product, cannot find shelter under Section 201(c). Indeed, National Geographic seeks to do exactly what the Court in the *Tasini* decision said that publishers cannot do: rely upon Section 201(c) to authorize the reuse of freelance authors' works when to do so "would diminish the Authors' exclusive rights in . . . [those works]." *Tasini*, 121 S.Ct. at 2390.

The primary interest of ASMP and the other *amici* in this case is to preserve the affirmation of authors' rights represented by this Court's decision in *Tasini* and avoid relitigating the question of statutory construction already disposed of by the Court in that case. In *Tasini*, this Court issued a definitive interpretation of Section 201(c) and rejected the publishers' apocalyptic predictions of doom if they were not permitted to rely upon that provision to avoid paying freelance authors for the reuse of their work. Seeking to take advantage of the timing of the Eleventh Circuit's decision in this case, Petitioners here make the same arguments presented to (and rejected by) this Court in its *Tasini* decision—inclusive of the predictions of disaster if the decision below is allowed to stand.

While the Section 201(c) issue arises here in a different factual context than in *Tasini*, the resolution of that issue by the Eleventh Circuit is fully consistent with this Court's statutory analysis of that provision, as Respondents demonstrate in their brief opposing the grant of certiorari. But even if that were not the situation, there is simply no question worthy of granting certiorari presented by the

petition. Instead, the petition is merely an attempt to relitigate the questions of statutory construction already addressed in detail by this Court and decided in favor of freelance authors in *Tasini*. The *amici* joining in this opposition submit that there is no justification for revisiting issues decided a few months ago so that publishers may have the opportunity to attempt to regain the ground lost in the *Tasini* decision. The *amici curiae* organizations therefore urge the Court to deny the petition.

I. THE FRAMING OF THE "QUESTIONS PRESENTED" DOES NOT ACCURATELY DEPICT "THE COMPLETE NATIONAL GEOGRAPHIC" OR THE DECISION BELOW

Petitioners attempt to mislead the Court by stating that the first question presented by the decision below is "[w]hether a publisher's exact, image-based reproduction of a collective work in CD-ROM format" infringes the copyrights of freelance authors who contributed to that collective work. Pet. ("Questions Presented"). In truth, the CNG consists of more than just previously published issues of National Geographic Magazine. As the Eleventh Circuit made clear and as Petitioners seek to minimize, there are two other significant elements of the CNG—what the Eleventh Circuit called the Sequence and the Program—not reflected in Petitioners' characterization of the first question presented. Those two elements, one a montage of moving National Geographic magazine covers and the other a computer program enabling functional features designed to facilitate consumer use of the product, are combined with the reproductions of previously published issues of that magazine to form the CNG. To single out one feature of the product and to suggest that the one feature completely and fairly depicts the factual foundation for the question presented is, therefore, misleading and inaccurate.

Moreover, the Eleventh Circuit pointedly and specifically remarked that it was not deciding the very issue that the Petitioners claim is presented by the lower court's decision. The Eleventh Circuit itself rejected Petitioners' characterization of the case as "one in which there has merely been a republication of a preexisting work [previously published issues of National Geographic magazine], without substantive change, in a new medium . . . ." *Greenberg v. National Geographic Society*, 244 F.3d 1267, 1273 n.12 (11th Cir. 2001). As the Eleventh Circuit expressly stated, the CNG consists of more than a mere "media transformation". *Id.* Rather, the CNG is a combination of the Replica, Sequence and Program, and could not fairly be said to consist of any one of those elements separate and apart from the others. Yet the underlying premise of the first question presented is precisely such a mischaracterization.

Petitioners's second question presented is not based upon a holding of the court below, and in fact misrepresents that court's dictum. The Eleventh Circuit did not hold that Petitioners committed a fraud on the Copyright Office. In fact, all the court said on the subject (in a footnote) was that the National Geographic Society "may not have intentionally perpetrated a fraud on the Copyright Office." *Id.* at 1273 n.13. Whether the Society did so or not was not decided by the Eleventh Circuit or, for that matter, by the district court; nor was it pertinent to the decision of either court.

Petitioners nonetheless seek to utilize verbal alchemy to convert this footnote into a holding so as to justify consideration of the second question presented. In the absence of a holding, accepting such a question for review would be inconsistent with this Court's usual practice of reviewing issues that were actually decided by the court below and that are fairly presented by its decision.

II. THERE ARE NO COMPELLING REASONS TO ACCEPT REVIEW OF YET ANOTHER CASE PRESENTING A QUESTION OF STATUTORY INTERPRETATION UNDER SECTION 201(c)

In a revealing observation, Petitioners inform the Court that "[t]his is a straightforward case of statutory interpretation." Pet. 9. Accepting that statement as true, it reflects the fact that Petitioners believe that the Eleventh Circuit wrongly decided the Section 201(c) issue in the context of this case, and that they believe this Court should correct that alleged error. But this view misapprehends the fundamental purpose of certiorari review, which as this Court has often noted, is not for the purpose of correcting the errors of the lower federal courts.

The decision below is fully consistent with this Court's recent decision in *Tasini*, as Respondents make clear in their brief. But even if that were not true, any alleged inconsistency of the Eleventh Circuit's analysis with that articulated by the Court in *Tasini* does not justify granting certiorari in this case solely to correct the Eleventh Circuit's alleged error. In the wake of this Court's recent decision in *Tasini*, there is no substantial question of fundamental importance presented in the petition or by the decision of the court below. This Court has already defined the purpose and scope of Section 201(c), and nothing about the context of this particular case warrants the extraordinary step of doing so again so as to correct the alleged error of the lower court.

The absence of any compelling justification to grant the petition is even more evident given the nature of the lower court's alleged error. Petitioners contend that the Eleventh Circuit's analysis conflicts with that of this Court in *Tasini* because, according to Petitioners, the Eleventh Circuit focused on whether the CNG should be considered a "new work" whereas in *Tasini*, again in Petitioners' view, "[t]he privilege turns on the preservation of the integrity of the

original collective work, not the technology of the medium of reproduction." Pet. 11. It is this alleged conflict, Petitioners submit, that creates the justification for accepting review of this case even though this Court's detailed analysis of Section 201(c) was delivered just a few months ago.

As Respondents demonstrate in their brief, the putative conflict between the Eleventh Circuit's approach to Section 201(c) and this Court's treatment of the statute in *Tasini* does not exist. The Eleventh Circuit focused on the question whether the CNG was a "new" work because its combination of three disparate elements—the Replica, the Sequence and the Program—put that question squarely at issue. To suggest that this Court's analysis precluded such consideration of whether a "new work" has been created, as Petitioners strenuously argue, is to ignore the teaching of the Court in *Tasini*.

As part of its analysis of the statutory issue under Section 201(c), the Court suggested in *Tasini* that one way of characterizing a "revision" would be to label it a "new version" of the work being revised—the words the Court used were a "new compendium" consisting of "the entirety of the works in the Database". 121 S.Ct. at 2391. But the Court concluded that there was simply no way that the compendium of articles in the publishers' databases could reasonably be viewed as a "revision" of the original periodical works themselves.

Consistent with this approach, the Eleventh Circuit found that the CNG was not merely a "revision" of the original editions of the National Geographic; rather, it was a new work containing many other elements, all of which were interrelated and integrated into a product useful for consumers.

Even if one were to accept Petitioners' assertion (which in fact is demonstrably untrue) that there is a "conflict" between

the analysis of the statute by the Eleventh Circuit in this case and the analysis of Section 201(c) by this Court a few months later in *Tasini*, that "conflict" consists at most of a difference in approach driven by differences between the two works at issue in this case and in *Tasini*. In this case, the Eleventh Circuit held that "common-sense copyright analysis" compelled the conclusion that the combination of the Replica, the Sequence and the Program "created a new product...in a new medium, for a new market that far transcends any privilege or other mere reproduction envisioned in 201(c)." 244 F.3d at 1273. While the CNG contained intact issues of National Geographic, the CNG itself included the additional elements of the Sequence and the Program. Given the nature of the CNG, the Eleventh Circuit's analysis did not end (as Petitioners appear to argue it should have) merely because intact periodicals were one part of the CNG. The court still had to decide whether the CNG as a whole constituted a mere revision of the original editions of National Geographic (the Replica). In answering that question, the lower court's characterization of the CNG as a new work was simply its way of explaining why the CNG was more than just the "revision" authorized by the Section 201(c) privilege.

By contrast, the databases at issue in *Tasini* did not contain intact issues of the New York Times. 121 S.Ct. at 2385-86.[2] So there was no occasion for this Court to decide whether the databases should be considered "new" works because of their inclusion of intact issues of that newspaper.

Accordingly, the alleged conflict between the two decisions is at most ephemeral. More important, there is no basis for concluding that applying what Petitioners view as the *Tasini* test would have led the Eleventh Circuit to arrive at

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[2] The Court observed, however, that even if the databases contained intact copies of the New York Times, the databases still could not be characterized as "revisions" of any one periodical edition. *Id.*

a different conclusion. In fact, the two decisions are consistent with each other in their interpretation of the statute in light of its purposes and legislative history. Accepting this case for review and then summarily vacating and remanding the Eleventh Circuit's decision, which Petitioners urge would be appropriate, would therefore be futile and wasteful of judicial resources.

Furthermore, the circumstances of this case do not justify issuance of a "GVR" order (grant certiorari, vacate the judgment below, and remand the case) under the standards articulated by recent decisions of this Court. In *Lawrence v. Chater*, 516 U.S. 163 (1996), and *Stutson v. United States*, 516 U.S. 193 (1996), the Court observed in both the civil and criminal context that its GVR power should be exercised "sparingly." The Court acknowledged that "a wide range of intervening developments . . . may justify a GVR order." *Chater*, 516 U.S. at 173. The Court nonetheless made clear that a GVR order is appropriate only where "we have reason to believe that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and where it appears that such a redetermination may determine the ultimate outcome of the litigation . . . ." *Id.* at 167. In applying this standard, the Court required a "reasonable probability" that the intervening development would make a difference in the outcome.[3]

This is manifestly not such a case. No reasonable reading of the Eleventh Circuit's decision would lead to the conclusion that the lower court would have found the CNG to

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[3] *Chater* was an example of such a case. There the federal government changed its interpretation of the federal benefits law at issue after the court of appeals decision. The Solicitor General accordingly not only urged the Court to grant certiorari, but also to issue a GVR order. The Court acceded to that request in light of its conclusion that there was a "reasonable probability" that the court of appeals would consider the new agency interpretation to be "outcome determinative." *Id.* at 174.

be a "revision" under this Court's teaching in *Tasini*. This is especially true given that the Eleventh Circuit's decision in this case was issued after the Second Circuit decision in *Tasini*, which was subsequently affirmed by this Court.

Even more fundamentally, the Eleventh Circuit was utterly convinced that the Section 201(c) phrase "that particular collective work" could not be "stretch[ed]" to encompass the Sequence and Program elements of the CNG. 244 F.3d at 1272. There is simply no "reasonable probability" that the Eleventh Circuit, reconsidering this case in light of this Court's decision in *Tasini*, would depart from its conclusion that the CNG "is in no sense a 'revision.'" *Id.*

Finally, the Petitioners' dire predictions about the impact of the Eleventh Circuit's decision on historical archives and access to periodicals by the public have all been heard before in the context of *Tasini*—and were rejected by the Court as reasons to restrict the rights of authors under Section 201(c). 121 S.Ct. at 2393-94. Like this Court in *Tasini*, the Eleventh Circuit made specific mention of the alternatives (such as mandatory license fees) to injunctive relief that should be considered in the first instance by the district court. The appropriate forum for considering the publishers' concerns about the impact of the two decisions on their products is the trial court, not this Court. The Petitioners in this case should, like the publishers in *Tasini*, present those concerns to the district court as it considers the appropriate relief to be awarded. If the Petitioners here (and the publishers in *Tasini*) are dissatisifed with the scope and form of relief granted by the district courts, they can avail themselves of appellate review without the need for further intervention by this Court.

Respectfully submitted,

VICTOR S. PERLMAN *
AMERICAN SOCIETY OF MEDIA
PHOTOGRAPHERS
150 North Second Street
Philadelphia, PA 19106-1912
(215) 451-0884

* Counsel of Record

August 30, 2001

APPENDIX

LIST OF INDIVIDUAL *AMICI*

ADVERTISING PHOTOGRAPHERS OF AMERICA
AMERICAN SOCIETY OF JOURNALISTS AND AUTHORS
AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS
ARTISTS RIGHTS SOCIETY
AUTHORS GUILD
EDITORIAL PHOTOGRAPHERS
NORTH AMERICAN NATURE PHOTOGRAPHY ASSOCIATION
OUTDOOR WRITERS ASSOCIATION OF AMERICA
PICTURE AGENCY COUNCIL OF AMERICA
SOCIETY OF CHILDREN'S BOOK WRITERS AND ILLUSTRATORS
TEXT AND ACADEMIC AUTHORS ASSOCIATION

(5)

Supreme Court, U.S.
FILED

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No. 01-186

IN THE

Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC ENTERPRISES, INC., AND MINDSCAPE, INC.,
Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF OF *AMICI CURIAE* IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI FILED IN SUPPORT OF PETITIONERS

JOSEPH M. BECK
Counsel of Record
KILPATRICK STOCKTON LLP
Suite 2800
1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6406

August 29, 2001

Balmar Legal Publishing Services, Washington, DC 20005 (202) 682-9809

22pp

QUESTION PRESENTED

Whether a reproduction on a CD-ROM of a printed collective work, presented to the user of the reproduction with the articles, photographs, and advertisements in a format identical to the original print publication, falls outside the privilege of 17 U.S.C. § 201(c) merely because the CD-ROM is enabled by a computer program or contains a short audiovisual introduction.

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INTEREST OF THE *AMICI CURIAE*

Amici curiae include the following parties:

Magazine Publishers of America, Inc. (MPA), established in 1919, is the largest association for the consumer magazine industry, representing more than 240 domestic publishing companies with more than 1,400 magazine titles. In weekly, biweekly, and monthly publications, MPA members provide broad coverage of domestic and international news, consumer affairs, law, literature, religion, politics, science, sports, agriculture, industry, and many other topics. MPA has a long and distinguished record of activity in defense of the First Amendment and the copyright laws.

Newspaper Association of America, Inc. (NAA) is a nonprofit organization representing the interests of more than 2,000 newspapers in the United States and Canada. NAA members account for 87 percent of the U.S. daily newspaper circulation and a wide range of non-daily newspapers. One of NAA's key strategic priorities is to advance newspapers' First Amendment interests, including the ability to publish news and information.

Association of American Publishers, Inc. (AAP) is the leading national trade association of the U.S. book and journal publishing industry. AAP members include most of the major commercial book publishers in the United States, as well as many nonprofit publishers, university presses, and scholarly and scientific journals. AAP members publish hardcover and paperback books in every field of interest, as well as computer software, databases, e-books, and other electronic products. AAP members frequently publish anthologies, compilations, and other collective works in print and electronic format.

Advance Publications, Inc. directly or through its subsidiaries, publishes daily newspapers in 22 cities and business journals in 37 cities throughout the United States, as

well as 18 magazines with nationwide distribution and numerous Internet websites.

The Copley Press, Inc. publishes nine daily newspapers in California, Illinois, and Ohio, including *The San Diego Union-Tribune*, and it operates Copley News Service, an international news service. Archives from many of the company's newspapers are available to the public through licenses to a variety of database providers.

Dow Jones & Company, Inc. publishes *The Wall Street Journal*, a national newspaper published each business day; WSJ.com, the largest paid Internet website with more than 550,000 paid subscribers; Dow Jones Newswires, real-time, twenty-four hour newswires distributed electronically to subscribers; *Barron's*, a weekly newspaper of business and finance; and through its Ottaway Newspaper, Inc. subsidiary, nineteen daily and seventeen weekly newspapers.

Forbes Inc. publishes *Forbes Magazine* and several other publications, including *Forbes Global*, *Forbes ASAP*, and *Forbes FYI*. It also owns Forbes.com Inc., a leading Internet media company providing commentary, analysis, tools, and real-time reporting for business and investment leaders.

Gannett Co., Inc. is a news and information company that publishes 98 daily newspapers in the U.S., including *USA Today*, and a number of non-daily publications, including *USA Weekend*, a weekly magazine. Gannett's 100-plus websites include USA TODAY.com. Gannett also owns and operates 22 television stations and a national news service.

Georgia Press Association is a nonprofit corporation comprised of 33 daily newspapers and 118 weekly newspapers published throughout the State of Georgia. It advocates for its members and for the preservation and extension of the public's right to know.

Gruner + Jahr USA Publishing is a leading publisher of magazines including *Inc.*, *Family Circle*, *Rosie*, *Parents*,

Child, *HomeStyle*, *Fitness*, *YM*, and *Fast Company*, and has a total monthly circulation in excess of 15 million readers.

Hachette Filipacchi Magazines, Inc. publishes more than two dozen magazines including *Elle*, *Woman's Day*, *Home*, and *Car and Driver*.

The Hearst Corporation is a diversified, privately held media company that publishes newspapers, consumer magazines, and business publications. Hearst also owns a leading features syndicate, has interests in several cable television networks, produced movies and other programming for television, and is the majority owner of Hearst-Argyle Television, Inc., a publicly held company that owns and operates numerous television broadcast stations.

Morris Communications Corporation is a business corporation based in Augusta, Georgia. It publishes daily and weekly newspapers in Alaska, Arkansas, Florida, Georgia, Kansas, Minnesota, Missouri, Nebraska, Oklahoma, South Carolina, South Dakota, Tennessee, and Texas. It also publishes magazines and books nationally.

The New York Times Company publishes *The New York Times*, a national newspaper with an approximate circulation of 1.5 million during the week and 1.7 million on Sundays, *The Boston Globe*, and 15 regional newspapers. The New York Times Company operates 8 television stations and 2 radio stations. It also operates New York Times Digital, which runs the company's major Internet websites. The New York Times Company licenses its works for use in electronic databases and for CD-ROM projects.

New Yorker Magazine, Inc. publishes *The New Yorker*, a magazine with a weekly worldwide distribution base of over 850,000. The magazine has been published since 1925 and is consistently recognized for its general excellence.

Playboy Enterprises is a brand-driven, international multimedia entertainment company that publishes editions of *Playboy* magazine around the world; operates Playboy and

Spice television networks and distributes programming via home video and DVD globally; licenses the Playboy and Spice trademarks internationally for consumer products; is developing a Playboy-branded, location-based entertainment business anchored by casinos; and operates Playboy.com, a leading men's lifestyle and entertainment website.

Primedia Inc. is a leading provider of targeted content both on-line and in print. Primedia publishes more than 230 magazines, directories, newsletters, and other publications including titles such as *Seventeen*, *New York*, *Chicago*, *Fly Fisherman*, *American Baby*, *Telephony*, and *American Demographics*.

Time Inc. is the largest publisher of general interest magazines in the United States. Its 64 magazines include *Time*, *Fortune*, *Sports Illustrated*, *People*, *Money*, and *Entertainment Weekly*. Time Inc. is a wholly-owned subsidiary of AOL Time Warner Inc.

The Tribune Company is a media industry leader with operations in the major markets of the United States, including eighteen of the top thirty markets. Through television, newspapers, radio, and the Internet, the Tribune reaches eighty percent of U.S. households. Among the newspapers The Tribune Company publishes are *The Chicago Tribune*, *Los Angeles Times*, *Newsday*, *Orlando Sentinel*, and *South Florida Sun-Sentinel*.

All *amici curiae* are publishers, or associations of publishers, of newspapers, magazines, books, or journals. Many have used freelance authors or photographers in creating their collective works.

In the wake of this Court's decision in *New York Times Co. v. Tasini*, 533 U.S. ___, 121 S. Ct. 2381 (2001), The New York Times Company announced that approximately 115,000 articles by 27,000 freelance authors would be deleted from LEXIS/NEXIS and other electronic databases. *See* David D. Kirkpatrick, *The Supreme Court: The Reaction; Publishers Set to Remove Older Articles From Files*, N.Y. Times, June

26, 2001, at A14. Similarly, Time, Inc. announced that its magazines, including *Time* and *Sports Illustrated*, would delete freelance contributions from electronic databases. *See id.* *Amici curiae* believe that many other publishers will follow suit.

Publishers are not only removing freelance contributions from electronic databases; The San Diego Union-Tribune announced that because of the expense and difficulty of identifying potentially infringing articles, it would block electronic access to all of its articles originally published prior to January 1, 2000. Similarly, other publishers such as New Yorker Magazine, Inc. have simply not made their entire historical archives available because of the ambiguities of how courts might interpret Section 201(c).

In its decision in *Tasini*, this Court sought to strike a balance between authors' rights and the rights granted to publishers under Section 201(c). That balance, however, was upset by the Eleventh Circuit's decision in *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001), decided without the benefit of *Tasini*. *Greenberg* goes far beyond *Tasini* by creating serious confusion regarding all electronic republications and nearly all revisions and updates of publishers' collective works. Because of the Eleventh Circuit's opinion in *Greenberg*, *amici curiae* face substantial uncertainty if they republish their magazines, newspapers, books, and journals in what is essentially an electronic microform or revise their works by including additional articles, photographs, or drawings. As a result, *amici curiae* anticipate that electronic databases will contain even fewer works than feared at the time of *Tasini*, and that publishers throughout the country may hesitate, for example, to include indices with traditional microfilm or to update encyclopedias.

STATEMENT OF THE CASE[1]

Respondents Jerry and Idaz Greenberg (collectively, the "Greenbergs"), having previously authorized use of their photographs in *National Geographic*, filed this action against Petitioners National Geographic Society, National Geographic Enterprises, Inc., and Mindscape, Inc. (collectively, the "Society") alleging that publication of the same works in CD-ROM collections of *National Geographic* magazine infringed copyrights in those photographs. The district court held that *The Complete National Geographic* constituted a "revision" of the paper copies of *National Geographic* and that the use of the Greenbergs' photographs fell within the privilege to publish a "revision" established under 17 U.S.C. § 201(c). Accordingly, the district court granted summary judgment to the Society and dismissed the copyright counts against it; the Greenbergs appealed.

Fully aware that this Court had granted *certiorari* in *Tasini*,[2] and ruling less than one week before this Court was scheduled to hear oral arguments in *Tasini*, the Eleventh Circuit held that Section 201(c) did not permit the Society to publish an exact, image-based reproduction of its collective

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[1] In accordance with S. Ct. R. 37.6, *amici curiae* state that they and their counsel authored the entirety of this brief and that counsel for neither party authored it in whole or in part. Further, *amici curiae* disclose that other than themselves, their members, or their counsel, no other person or entity made any monetary contribution to the preparation or submission of this brief. In the interest of full disclosure, it is noted that National Geographic Magazine Group, a subsidiary of National Geographic Society, is a member of *amicus curiae*, Magazine Publishers of America. Further, the National Geographic Society Book Division is a member of *amicus curiae*, Association of American Publishers.

[2] On page one of their Supplemental Brief Supporting Defendants/Appellees filed November 15, 2000, many of the *amici curiae* informed the Eleventh Circuit that this Court had granted *certiorari* in *Tasini* on November 6, 2000, and that as a result, it could refrain from construing Section 201(c) pending this Court's decision on the issue.

work in electronic form simply because it contained (1) an enabling, potentially copyrightable computer program and (2) a brief, potentially copyrightable introduction. *Greenberg v. National Geographic Society*, 244 F.3d 1267, 1272 (11th Cir. 2001). Despite the fact that this Court subsequently heard oral arguments regarding the scope of the same Section 201(c) privilege, the Eleventh Circuit thereafter denied the Society's petition for rehearing and rehearing *en banc*.

Written consent to file this Brief of *Amici Curiae* in Support of Petition for Writ of *Certiorari* Filed in Support of Petitioners was granted by Terrence B. Adamson, Executive Vice President of National Geographic Society on behalf of Petitioners and by Norman Davis, Counsel of Record for Respondents. Copies of these consents have been filed and served concurrently with this Brief.

SUMMARY OF THE ARGUMENT

The Court in *Tasini* ruled that the databases at issue in that case were not revisions under Section 201(c). The Court, however, also carefully explained that Section 201(c) would permit a print collective work to be revised as an electronic collective work as long as the context and position of the contributions remained the same. After *Tasini*, therefore, the question one must ask in determining if a republication of a collective work in electronic form is permitted by Section 201(c) is whether "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented." *Tasini*, 121 S. Ct. at 2384.

The Eleventh Circuit found that *The Complete National Geographic* fit exactly within the criteria which *Tasini* would require of publishers relying on Section 201(c): the context and position of the contributions—including the photographs—remained the same on the CD-ROM as they did in the paper copies of *National Geographic* magazine. *See Greenberg*, 244 F.3d at 1269 ("Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine."). Because the Eleventh Circuit was unaware that

Tasini would soon hold that just such electronic publications do not violate the copyrights of freelance contributors, however, it did not consider the dispositive nature of its finding. Instead, the court erroneously concluded that the mere addition of a computer program (which of course was necessary for the CD-ROM to operate), and a short introduction, created a "new" collective work that fell outside the Section 201(c) privilege. Yet, all electronic reproductions must utilize a computer program; therefore, the Eleventh Circuit's approach potentially removes all electronic reproductions from the scope of the Section 201(c) privilege, and not merely the types of databases of concern in *Tasini*.

In addition, by focusing on the addition of new copyrightable elements that this Court did not find relevant in *Tasini*, the Eleventh Circuit has, for a separate reason, placed at risk the republication of collective works that contain any amount of freelance materials in any form. As a result, many publishers may be less likely to republish their collective works even in print media, if only because a revised introduction or some similar "new copyrightable element" could place them at risk of exceeding the 201(c) privilege as defined in *Greenberg*.

That such a result would obtain is all the more unwarranted in view of the extraordinary legislative history that explains Congress's intent in enacting Section 201(c). Congress made it crystal clear that articles from a collective work (such as an encyclopedia) could be republished in an updated version containing substantial, independently copyrightable elements. *See* House Report 94-1476 at 123 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5737; *see also* discussion *infra* pp. 13-14.

The *Greenberg* opinion, however, is not only a premature ruling in derogation of *Tasini* and in conflict with the legislative history behind Section 201(c); *Greenberg* also disrupts the careful balance achieved by Congress between the public's interest in access to creative works and the need for appropriate incentives for authors to create those works.

This Court, therefore, should grant *certiorari* and either reverse or remand the case for consideration in light of *Tasini*.

REASONS FOR GRANTING THE WRIT

Tasini addressed the meaning of the "revision" privilege found in Section 201(c). The Court held that the *form* of reproduction—as independent articles in isolation and without the context of the entire collective work—placed the publications at issue in *Tasini* outside the 201(c) revision privilege because "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented." *Tasini*, 121 S. Ct. at 2384.

Two of the three databases at issue in *Tasini*—LEXIS/NEXIS and the New York Times OnDisc—stored articles from collective works in a text-only format "without the graphics, formatting, or other articles with which the article was initially published." *Id.* at 2391. While the other database, General Periodicals OnDisc (GPO), showed "each article exactly as it appeared on the original work's pages, complete with photographs, captions, advertisements, and other surrounding materials," *id.* at 2386, a user viewing any particular article would not be presented with "any material published on other pages of the original periodical." *Id.* at 2391. Articles accessed through any of the three databases lacked "links to articles appearing on other pages of the original publication." *Id.* at 2386.

According to the Court in *Tasini*, the "crucial fact" that placed the databases outside the scope of the Section 201(c) privilege was that they "store[d] and retrieve[d] articles separately within a vast domain of diverse texts," rather than presenting each article in context and as part of the entire collective work. *Id.* at 2393. In reaching this conclusion, the Court specifically approved of the current understanding that reproduction of a collective work on microfilm or microfiche qualified for the Section 201(c) privilege. Indeed, the Court described the rationale for this understanding when it explained that "articles appear on microforms, writ very

small, in precisely the position in which the articles appeared in the newspaper." *Id.* at 2391. Therefore, as long as "the user first encounters [an] Article in context," it is immaterial that "the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on [one] Article, to the exclusion of surrounding material." *Id.* For the Court, even the image-based GPO database, which showed each printed page exactly as it originally appeared in the print publication, could not be said to present the articles in context in the same way as an article on microfilm. Although all the pages on which the GPO article appeared may have been visible to the user, pages adjacent to those on which the article appeared were not visible. *See id.*

Significantly, the Eleventh Circuit, ruling without the benefit of the *Tasini* rationale, *expressly found* that *The Complete National Geographic* was, in fact, an exact reproduction of the original print publication falling precisely within the criteria subsequently set out in *Tasini*:

> What the user of the CNG sees on his computer screen, therefore, is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text. Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine.

Greenberg, 244 F.3d at 1269. Thus, *The Complete National Geographic*, according to the Eleventh Circuit, satisfied *Tasini*'s requirements by presenting each article and photograph to the user in context—in the exact position in which it appeared in the print publication, and with all the content on adjacent pages as well. Whereas articles accessed through any of the three databases of concern in *Tasini* lacked "links to articles appearing on other pages of the original

publication,"[3] *id.* at 2386, articles and photographs in *The Complete National Geographic* are each linked to each other; moreover, each monthly magazine is linked to the issues published immediately before and after it. For example, after reading the last page of an article in *The Complete National Geographic*, the user need only press a button to "flip" to the next page. Similarly, upon reaching the end of the August 1995 issue, the user can "flip" to the next page—the cover of the September 1995 issue.

In sum, the Eleventh Circuit ruled that *The Complete National Geographic* met the precise criteria shortly thereafter imposed by this Court upon electronic works publishers wishing to rely on Section 201(c); it then raised concerns that such publishers could not publish electronic versions of their works *even if* they addressed the problems identified in *Tasini*. Rather, the Eleventh Circuit relied heavily on its conclusion that despite compliance with all the *Tasini* criteria, a work was transformed into a "new" collective work if it included any new copyrightable matter, *see Greenberg*, 244 F.3d at 1273, such as a program that enables the electronic database to operate or a brief introduction to the entire CD-ROM.

The effect of the Eleventh Circuit's decision extends far beyond what this Court intended in *Tasini*. For example, publishers of image-based electronic versions of complete collective works now face confusion about whether their actions violate freelance authors' copyrights: for whether such works are provided through the Internet, on CD-ROM, or by some other computerized means, electronic documents require the use of a program to convert the data into a form

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[3] The *Tasini* Court explained that although *Remembering Jane*, a freelance article by Mary Kay Blakely, began on page 26, the article was not reproduced as part of the collective work or a revision of that collective work, even in an image-based format, because the materials on pages 25 and 27 were not visible. 121 S. Ct. at 2386 n.2, 2391-92.

readable by humans.[4] Moreover, the Eleventh Circuit has disregarded the principle of media neutrality as codified by Congress;[5] no matter how publishers attempt to republish collective works in electronic form, the resulting electronic work will always be subject to challenge as a "new" collective work under Eleventh Circuit law.

The adverse effects of *Greenberg* are not limited to a potential ban of all *electronic* publishing that incorporates works by freelance authors. The Eleventh Circuit, possibly without limiting its reasoning to electronic works, found that the addition to a collective work of other works "themselves the subject matter of copyright" rendered the entire collective work incapable of satisfying the requirements of Section 201(c). *Greenberg*, 244 F.3d at 1273 & n.12. Thus, even non-electronic publications of a collective work containing any independently copyrightable material could fall outside the scope of the Section 201(c) privilege. For example, the Eleventh Circuit's analysis could jeopardize every publishers' privilege of reproducing their collective works on microfilm or microfiche—a privilege specifically recognized by the Court in *Tasini*. 121 S. Ct. at 2391. Because a publication need only contain a single independently copyrightable element to fall outside the Section 201(c) privilege,

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[4] While emphasizing the importance of the copyrightability of the computer program, the Eleventh Circuit failed to explain the precise role that fact played in its analysis. Indeed, the court explicitly refused to describe the program's importance, instead explaining that "we need not decide in this case whether the addition of only the Program would result in the creation of a new collective work." *Greenberg*, 244 F.3d at 1273 n.12.

[5] The Copyright Act was designed for application with changing technology. For example, a work may be copyrightable if it is "fixed in any tangible medium of expression, now known or later developed." *See* 17 U.S.C. § 102(a); *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 683, 702-703 (2d Cir. 1998) (noting that copyright protection does not "depend upon the form or medium in which the work is fixed") (quoting H.R. Rep. No. 94-1476, at 52 (1976)).

microform reproductions that contain independently copyrightable elements such as introductory materials and indices might not be privileged under the Eleventh Circuit's reasoning.

The Eleventh Circuit's interpretation of 17 U.S.C. § 201(c) runs directly contrary to the legislative history explaining that section. An early draft of Section 201(c) gave publishers the right to publish freelance contributions in the original periodicals or "a composite work like that of the publisher." *Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 88th Cong., 1st Sess., Copyright Law Revision, Part 2 (H. Judiciary Comm. Print 1963), at 385. This language led Harriet Pilpel, an experienced literary property attorney who represented freelance authors, to worry that the section, as drafted, was "less favorable than the present law," presumably because it could allow *The Washington Post*, for example, to sell one of its freelance articles for later publication in *The New York Times*, arguably a "like" composite work. *See id.* at 151-52.

Responding to this concern, the Register of Copyrights agreed to clarify the language to refer only to "that particular composite work." *Id.* at 153. Publishers, however, observed that this language might not allow them to republish revisions of their collective works, selecting and discarding freelance contributions as they chose. *Id.* at 261. The Register of Copyrights agreed that this revised language was too restrictive and that the core privilege to which publishers were entitled should include the privilege of reproducing and distributing freelance contributions of "that collective work and any revisions of it." Copyright Law Revision, Part 5, at 9.

After Pilpel pointed out that under this language, a publisher could revise individual contributions, as opposed to the collective work, *id.* at 152, the Register of Copyrights refashioned Section 201(c) to make clear that the "any revision" language authorized any changes to the "particular

collective work" as a whole, but not to the individual contributions. *Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law; 1965 Revision Bill*, 89th Cong., 1st Sess., Copyright Law Revision, Part 6 (H. Judiciary Comm. Print 1965), at 69. This final compromise, mediated by the Copyright Office, yielded the present language of Section 201(c). To clarify the balance finally struck between publishers and freelance authors, the House Report provided the following examples of what publishers could and could not do under Section 201(c):[6]

> Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and *could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it*; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. 94-1476, at 122-23 (emphasis added).

An examination of the differences between a 1980 edition of an encyclopedia and a 1990 revision of it strikingly exposes the Eleventh Circuit's flawed reasoning that the addition of independently copyrightable material destroys the Section 201(c) privilege. First, many encyclopedia revisions contain independently copyrightable introductory material such as a new introduction, forward, or preface. Indeed, some publishers include such material with every revision. Yet according to the Eleventh Circuit, a new introduction, forward, or preface to the revised encyclopedia could destroy the publisher's Section 201(c) privilege.

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[6] Congress's amplification is approvingly quoted in both *Tasini* and *Greenberg*. *See Tasini*, 121 S. Ct. at 2389; *Greenberg*, 244 F.3d at 1273.

Second, publishers often change the front cover of encyclopedias when revisions are released. While revised covers might simply include non-copyrightable items, such as titles, names, and numbers, they also could include new photographs and drawings that would be independently copyrightable. Under the Eleventh Circuit's view, however, simply adding a photograph to the cover of an otherwise exact printed copy of an encyclopedia could render it a "new" collective work and make it ineligible for the reproduction and distribution privilege under Section 201(c).

Third, and most important, one cannot legitimately argue that Congress expected a 1990 revision of an encyclopedia to contain no new and independently copyrightable contributions that did not appear in the 1980 version. Congress knew that each coming decade, like each decade before it, would include numerous events that would not only be expected to appear in an encyclopedia, but that would have to be included to make the encyclopedia revision useful and complete. In 1981, the world learned of the discovery of AIDS; in 1986, the world watched in horror as the space shuttle Challenger exploded; and in 1989, the world cheered as the Berlin Wall fell. Certainly a 1990 revision of a 1980 encyclopedia would include independently copyrightable articles, photographs, or drawings related to AIDS, the Challenger disaster, and the fall of the Berlin wall—events that occurred since publication of the 1980 version. Yet, according to the legislative history, the inclusion of such "new copyrightable matter" should not prevent the publisher of the 1990 revision from using, without alteration, another author's contribution concerning William Shakespeare or the American Civil War as originally published in its 1980 edition. Rather, this type of use was exactly what Congress envisioned when it explained that a publisher "could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it." H.R. Rep. 94-1476, at 122-23. Yet, under *Greenberg*, such new material could dissuade publishers from including pre-existing freelance material in the revision.

Finally, *Greenberg* upsets the Constitutional balance between providing appropriate incentives to authors and maintaining public access to works by those authors. This Court's concern that the LEXIS/NEXIS database "effectively overrides the Authors' exclusive right to control the individual reproduction and distribution of each Article," *Tasini*, 121 S. Ct. at 2393, is not present here. The Section 201(c) privilege, as defined by *Tasini*, does not give publishers of collective works the right to republish an individual contribution apart from the collective work's other contributions. Nor does it permit an individual article's inclusion in another publisher's collective work.[7] On the other hand, by transforming Section 201(c) from a "presumed . . . privilege" into a gamble for publishers—one with prohibitively high risks—*Greenberg* will reduce the availability of creative works to the public by subordinating the "cause of promoting broad public availability of literature, music, and the other arts" to private reward. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

Had the Eleventh Circuit awaited a ruling by this Court concerning Section 201(c), it surely would have recognized that its own express finding—that *The Complete National Geographic* presented the Greenbergs' freelance contributions exactly as they appeared in the print magazine—placed the CD-ROM squarely within the Section 201(c) privilege. Instead of investigating whether independently copyrightable

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[7] Even before *Tasini*, freelance authors who chose to authorize publication in collective works typically retained virtually all their copyrights granted to them by Section 106, including the right to reproduce the work in copies, prepare derivative works, distribute copies of the work, perform the work publicly, and display the work publicly. *See* 17 U.S.C. § 106. For example, a short story author whose work appeared in *The New Yorker* pursuant to Section 201(c) could, in the absence of a license agreement to the contrary, create or authorize the creation of a book or motion picture derived from that story; the author could also combine several of her works and sell them together as a book of short stories.

material appeared somewhere "in" the collective work (or in the case of a computer program, somewhere in connection with it), the Eleventh Circuit would have recognized that Congress intended the Section 201(c) privilege to embrace revisions that included new copyrightable material.

CONCLUSION

The opinion in *Greenberg* eviscerates the Section 201(c) privilege. The adverse consequences predicted by many of the *amici* when *Tasini* was before this Court will be multiplied if *Greenberg* is allowed to stand unmodified. That such a result will come about is especially unfortunate in view of the pains taken by this Court in *Tasini* to preserve a sanctuary for electronic publishing—and in view of the manifest intent of Congress. Through an interpretation of the statute inconsistent with the language and the legislative history, the Eleventh Circuit has brought into question conduct long considered appropriate under Section 201(c)—including republication on microfilm or microfiche of a collective work containing a new forward or the revision of an encyclopedia to reflect history's advance.

This Court should grant *certiorari* and reverse the Eleventh Circuit's decision. At the very least, this Court should grant *certiorari*, vacate the Eleventh Circuit's erroneous decision, and remand the case for consideration in light of this Court's decision in *Tasini*.

Respectfully Submitted,

JOSEPH M. BECK
Counsel of Record
KILPATRICK STOCKTON LLP
Suite 2800
1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6406

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IN THE
Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
AND MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

REPLY TO BRIEF IN OPPOSITION

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

September 10, 2001

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Respondents fail to come to grips with this Court's teaching in *New York Times Co. v. Tasini*, 121 S. Ct. 2381 (2001), or the implications of the decision below for the creation of archives of collective works. Respondents do not deny that they authorized the publication of their freelance contributions in *National Geographic* magazine, or that the Complete National Geographic (CNG) reproduces those contributions intact in their original context. Rather, their argument (and the decision below) is based on the proposition that a publisher necessarily infringes the copyrights of its freelance contributors by creating an archive of its own collective works *even if* each freelance contribution remains in the precise context of the original collective work. *See* Opp. 8. That is so, respondents assert, because the Copyright Act contains an "express prohibition" on the reproduction of freelance contributions in a "new collective work." *Id.* Because a collection of collective works like the CNG is itself a collective work, they argue, it violates "the prohibition against new collective works." *Id.*

The problem with that argument is that no such "prohibition" exists. As petitioners have explained, the statute expressly authorizes publishers to reproduce freelance contributions to a collective work "as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series." 17 U.S.C. § 201(c). Nowhere does the statute state, suggest, or even hint that this privilege vanishes if the publisher creates a "new collective work." To the contrary, the latter two categories *invariably* involve the creation of a new collective work, and the very paragraph of the legislative history on which respondents rely specifically authorizes the inclusion of a freelance contribution in a new collective work—a later edition of an encyclopedia or magazine. *See* H.R. Rep. No. 94-1476, at 122-23 (1976).

Thus, as this Court explained in *Tasini*, the key issue under Section 201(c) is whether an individual freelance contribution is "presented to, and perceptible by" the end user in its "original context" as "part of the collective work to which the author contributed." 121 S. Ct. at 2390-92. The three databases at issue in *Tasini* fell outside the statutory reproduction privilege because in each database "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented," *id.* at 2384—*not* because each database was itself a "new collective work."

As the *Tasini* Court explained, the statute thus strikes a fundamental balance between the freelancer's copyright in an individual contribution and the publisher's copyright in the collective work. *See id.* at 2389. "If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand," but by the same token allows the publisher to benefit from the demand for the collective work. *Id.* The publisher can thus reproduce individual freelance contributions as part of the original collective work, but cannot *remove* such contributions from the original collective work and claim that they remain part of "that particular collective work," or "any revision of that collective work." 17 U.S.C. § 201(c). "It would scarcely preserve the author's copyright in a contribution as contemplated by Congress, if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author's contribution in isolation or within new collective works." *Tasini*, 121 S. Ct. at 2389 (internal quotation omitted).

Respondents seize on that single reference to "new collective works" to turn the overall statutory balance upside down. According to respondents, the *Tasini* Court thereby "said that the context requirement of Section 201(c) can be violated in *two* ways": *either* [1] "by lifting a contribution out of the context in which it first appeared to an end user, and

placing it in isolation," *or* [2] by creating "a new collective work," *even if the contribution remains in the original collective work.* Opp. 7 (emphasis added). But the *Tasini* Court said no such thing. To the contrary, the very passage on which respondents rely specifically reaffirms the balance between the freelancer's copyright in the individual contribution and the publisher's copyright in the collective work. *See* 121 S. Ct. at 2389. To say that a publisher cannot remove an individual contribution from a collective work and place it in a new collective work is not to say that a publisher cannot place the original collective work *in its entirety* in a new, and larger, collective work. The issue, as the *Tasini* Court explained, is whether a user perceives the individual contributions in the context of the original collective work, not whether a "new" collective work has been created.

Respondents thus miss the point by arguing that "Petitioners . . . attempt to create an *exception* to the prohibition where the author's contribution, and the original collective work in which it first appeared, are incorporated in a new collective work." Opp. 8 (emphasis added); *see also id.* ("[T]here is no *exception* to the express prohibition involving new collective works merely because an author's contribution remains in the 'context' in which it was originally published.") (emphasis added). Petitioners have no need for any such "exception" because the statute contains no such "prohibition" in the first place. Indeed, if the creation of a new collective work *per se* defeated the privilege, then the *Tasini* Court's discussion of context was completely unnecessary, because the "crucial fact" in *Tasini* would have been the creation of "new collective works," not the context in which the freelance contributions were presented.

The *Tasini* Court only underscored this point in its discussion of microfilm and microfiche. As the Court explained, microform "contains multiple editions" of a particular newspaper or magazine. 121 S. Ct. at 2391. Thus, under respondents' view, reproduction in microform should

infringe a freelancer's copyright because it is a "new collective work." But the *Tasini* Court went out of its way to note that microform "perceptibly reproduce[s] articles as part of the collective work to which the author contributed or as part of any 'revision' thereof" precisely because it presents the articles *in their original context*. *Id.* at 2391-92. If, as respondents contend, the creation of a "new collective work" defeats the 201(c) privilege wholly apart from the "context" in which a freelance contribution is reproduced, the *Tasini* Court's discussion of microform makes no sense.

Respondents' answer on this point is twofold. *First*, they insist that, "[c]ompletely contrary to the Petitioners' assertion, the *Tasini* Court did not hold that microform (microfilm or microfiche) reproduction qualifies for the Section 201(c) privilege." Opp. 9. But that is no answer at all. Obviously, the Court's discussion of microform was not a "holding," since the *Tasini* case did not involve microform. That discussion, however, illuminates the *reasoning* underlying the Court's holding, and that reasoning is squarely inconsistent with respondents' position and the decision below. *Second*, respondents assert that "the microform described by the Court would present the end user with the *original context* of 'that particular collective work' referenced in Section 201(c)." *Id.* (emphasis added). But again, that is no answer at all, because respondents' entire argument is premised on the notion that Section 201(c) prohibits the creation of "new collective works" *regardless* of the "context" in which contributions are presented. Because the CNG, like microform, contains an exact, image-based reproduction of every page of every issue of *National Geographic* magazine, the original context is preserved in a new medium, and the reproduction falls within the Section 201(c) privilege.

Respondents, however, deny that the decision below violates the bedrock principle of media neutrality. According to respondents, "[t]he Eleventh Circuit *did not hold* that reproduction of the Greenberg photographs in a different

electronic medium would be inherently impermissible." Opp. 11 (emphasis in original). But that is precisely the effect of the Eleventh Circuit's twin holdings that (1) the existence of copyrightable computer software in a CD-ROM leads to the creation of a "new collective work," and (2) the creation of a "new collective work" automatically defeats the Section 201(c) privilege. App. 9a-11a & n.12. Under that approach, a publisher can *never* reproduce its collective works on CD-ROM without infringing its freelancers' copyrights, because (as respondents themselves acknowledge) "[e]very CD-ROM does indeed require at least minimal software to permit page-by-page access to printed matter reproduced in a digital format." Opp. 11.

Respondents attempt to downplay the implications of this "draconian outcome," *id.*, by asserting that "the CNG goes far beyond what is *minimally necessary* in digital technology," *id.* at 11-12 (emphasis added). But the Eleventh Circuit adopted no such "minimal necessity" test, and any such test is utterly foreign to the statute and unworkable in practice. To the contrary, the Eleventh Circuit expressly attempted to distinguish CD-ROM from microform on the ground that CD-ROM contains "computer programs [that] are themselves the subject matter of copyright." App. 11a n.12. Accordingly, respondents do not so much defend as flee from the decision below by arguing that "a publisher wanting to reproduce an author's work in a digital format can satisfy Section 201(c) by utilizing a software program that simply stores the work and allows page-by-page display." Opp. 18. The Eleventh Circuit created no such safe harbor for *some* software, and in fact such a safe harbor conflicts with the court's reliance on the inherently copyrightable nature of *all* computer software.

Respondents' assertion that "the CNG contains other materials and other capabilities that even more forcefully support the Eleventh Circuit's holding of infringement," *id.* at 1, 12, thus misses the point. The Eleventh Circuit expressly acknowledged that "[e]very cover, article, advertisement, and

photograph appears [in the CNG] as it did in the original paper copy of the Magazine," and thus "[w]hat the user of the CNG sees on his computer screen . . . is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text." App. 4a. Under *Tasini*, that is the beginning and the end of this case. The fact that CNG provides additional benefits—like the ability to conduct electronic searches—does not negate the fact that it provides exact, image-based reproductions of past issues of *National Geographic* magazine, and thus presents all freelance contributions in their original context.[1] If, as respondents and the Eleventh Circuit suggest, the benefits provided by a new medium like CD-ROM defeat the Section 201(c) privilege, then the medium-neutrality principle is essentially a dead letter, because the whole point of reproducing collective works in new media is to take advantage of the benefits of those media.

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[1] Respondents' description of the technical aspects of the CNG is not only legally irrelevant but factually misleading. Among other things, respondents challenge "the Eleventh Circuit's observation that 'the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.'" Opp. 2 n.1 (quoting App. 4a). That challenge is inexplicable, because respondents themselves concede that "[t]he product's program does *not* provide that means." *Id.* at 2 (emphasis added). Rather, they assert (with no record support) that "the universal file format codes utilized in the product provide an easy means for an end user to open, edit and copy particular pages for manipulation." *Id.* But the theoretical possibility that a user could manipulate file format codes to remove an individual article from the CNG does not render petitioners liable for copyright infringement any more than does the possibility that a user could remove an individual article from the print version of the magazine with a pair of scissors and then copy or scan the image. Similarly, respondents' assertion that the CNG allows "[a]rticle-by-article inspection," *id.* at 2, 12, is misleading at best, because the CNG does not disaggregate articles from the original collective work; the user can engage in "article-by-article inspection" only by moving through the entire original issue, just as with a print version or microform. And the suggestion that the CNG includes "[a]dvanced search capability," *id.* at 2, 12, is similarly misleading, because the CNG does not allow the user to search the text of articles, but limits the search to an electronic version of the traditional print index.

Respondents also try to downplay the radical nature of the decision below by insisting that publishers can reproduce their own collective works in CD-ROM format by simply obtaining licenses from their freelance contributors. *See* Opp. 18-19. Respondents thus echo the Eleventh Circuit's casual suggestion that the district court should "consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work." App. 16a-17a. As petitioners have explained, however, it would be impossible as a practical matter to track down each one of the thousands of freelancers from around the world who have contributed to *National Geographic* over most of the last century to negotiate a retroactive license fee. Even suspending disbelief and assuming *arguendo* that National Geographic were able to track down each and every such freelancer, any single one could destroy the integrity of the entire project by simply refusing permission. Indeed, given that the alleged infringement has *already* taken place, petitioners would have essentially no bargaining power, and a freelancer would have no incentive to agree to a reasonable license fee. And the court in this case would have no power over any freelancers other than respondents, so that even if the court could impose a mandatory license fee here, it could not impose such a fee on other freelancers.

It is thus not "speculation," Opp. 18, but reality to acknowledge that the issue in this case is the ability of publishers to create electronic archives of their own collective works for the education and entertainment of future generations. The signal importance of that question warrants this Court's review. If CD-ROM archives of collective works are to vanish from the market, it should be because the Supreme Court of the United States has duly concluded that Congress has decreed that result, not because one panel of one court of appeals has interpreted one passage in the legislative history to prohibit the reproduction of anything that can be deemed a "new collective work." Nor does this Court have the luxury of allowing this issue to percolate among the lower

courts before granting review. Because CD-ROMs are distributed nationally, no publisher can take the risk of continuing to market a product that the Eleventh Circuit would deem infringing.

As explained by one group of petitioners' *amici* (who supported the *freelancers* in *Tasini* in light of the very different products at issue there), the ruling below threatens substantial harm to the public interest because "no collective work reproduced or distributed via CD-ROM, online technology, or other new technology requiring additional software to facilitate viewing or searching could, as a practical matter, ever qualify for the Section 201(c) privilege." Br. of *Amici Curiae* American Library Association *et al.* 13. As petitioners' other *amici* explain, that result is not only inconsistent with Section 201(c), but also "upsets the Constitutional balance between providing appropriate incentives to authors and maintaining public access to works by those authors." Br. of *Amici Curiae* Magazine Publishers of America *et al.* 16. Accordingly, this Court should review the Eleventh Circuit's conclusion that an exact, image-based reproduction of a collective work violates the copyrights of freelance contributors to that collective work.[2]

This Court should also review the Eleventh Circuit's accusation that National Geographic committed "fraud" on the Copyright Office when applying for a copyright registration. Respondents do not, because they cannot, defend that

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[2] Respondents err by asserting that petitioners have "waived any challenge" to the Eleventh Circuit's distinct conclusion that the use of the January 1962 cover in the CNG's brief introductory montage infringed their copyrights. Opp. 22. According to respondents, petitioners waived that point because they "did not identify that holding of infringement with the other 'Questions Presented' in their brief. *Id.* But, as the petition explains, *see* Pet. 17 n.2, that holding is subsidiary to the broader question whether the CNG itself infringes respondents' copyrights, and is thus "fairly included" within the first question presented, *see* S. Ct. Rule 14.1(a); *Lebron v. National R.R. Passenger Corp.*, 513 U.S. 374, 379-80 (1995).

accusation on the merits. Rather, they assert that the accusation is "dictum that in no way was relevant or essential to the court's holding of copyright infringement." Opp. 20; *see also id.* at 21 (characterizing accusation as "an aside that touches on a question that was not before the court."). That position is, to say the least, curious: if anything, the Eleventh Circuit's serious and manifestly erroneous accusation is *more*, not *less*, offensive to the extent it is gratuitous. And the Eleventh Circuit only added insult to injury by refusing even to consider the views of the Copyright Office on this issue of Copyright Office procedure. Indeed, this Court may wish to call for the Solicitor General to present the views of the United States in this case, so that the Copyright Office, the federal agency with statutory expertise and responsibility for the administration of the Copyright Act, will have an opportunity to be heard. *Cf. Tasini*, 121 S. Ct. at 2388 n.3, 2389 n.6 (relying on the views of the Register of Copyrights in construing Section 201(c)).

Although the issues in this case are worthy of plenary review, at the very least this Court should grant, vacate, and remand in light of *Tasini* (and, if appropriate, the views of the United States). Respondents' *amici* suggest that such a GVR is unnecessary because the publishers lost in both cases. Br. of *Amici Curiae* American Society of Media Photographers *et al.* 8-9. But there is no dispute that the Eleventh Circuit's reasoning is completely different from (and, petitioners submit, inconsistent with) *Tasini*'s reasoning. At the very least, this Court should afford the parties the opportunity to present the Eleventh Circuit with their very different interpretations of *Tasini* and its impact on this case.

CONCLUSION

For the foregoing reasons, and those set forth in the petition, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

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